89-1548

IN THE SUPREME COURT OF THE UNITED STATES

October Term 1989

No. _____

IRVIN D. STAGNER,
Pro Se Petitioner-Appellant

v.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER, JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

Appellees

PETITION FOR WRIT OF CERTIORARI TO

THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

Petitioner Pro Se
Irvin D. Stagner
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Wichita, KS 67211
316 264 2723

QUESTIONS PRESENTED

Did Congress separate by a line of demarcation (37 CFR 1.113) into two remedies for disputes in the examination of patent applications, one merit of the invention (37 CFR 1.191) and the other Administrative procedure used in the examination of patent application (37 CFR 1.181)?

Can a suit be filed in a District Court in accordance with 37 CFR 1.113, 37 CFR 1.181, 35 USCA 141 and 35 USCA 145 Title 5 USCA 500-706 and the Due Process of the Fifth Amendment of the Constitution, for review of the the Patent and Trademark Administrative Procedure in the examination of patents and then a defense of merit be entered only as a way to avoid the review of patent Administrative Procedure?

Who interprets a U.S. statutes, such as, 35 USC 103 and what obvious is,

does a quasi-judicial person, such as, a patent examiner have the right to have a interpretation of the statute separate from the cases in reference under that statute?

What was congress intent by 28 USC Rule 16(a, b. c. #3) of the Rules of Practice for the District court for the District of Kansas, to hold hearings or review by trial a Administrative record made before a United States Government Agency and what was congress intent by the Due Process of the Fifth Amendment of the Constitution United States and can that Due Process be applied to patent applications?

Can a Pro se conduct his own case in a trial court under 28 USC 1654, without counsel and without court prejudice and can a Pro Se, file for patent by a patent application, in the Patent office without prejudice of the patent office because he is Pro Se?

LIST OF OTHER PARTIES

List of parties to the proceedings in the court whose judgment is sought to be reviewed.

Judge Patrick F. Kelly.

Judge of the June 29, 1989, Summary Judgment, Memorandum and Order for the District Court for the District of Kansas.

Circuit Judge, Archer.

Senior Circuit Judge, Cowen.

Circuit Judge, Mayer.

Judges for the United States Court of Appeals for the Federal Circuit, that affirmed the District Court Summary Judgment entered June 29 1989, in a decision and Opinion entered January 25, 1990.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

To the Honorable, the Chief Justice and Associates Justices of the Supreme Court of the United States:

Irvin D. Stagner, the Petitioner Pro Se, herein, prays that a writ of certiorari issue to review the June 29, 1989, Summary Judgement, Memorandum and Order of the United States District Court for the District of Kansas, that

was affirmed by Decision of the United States Court of Appeals for the Federal Circuit and entered on January 25, 1990.

OPINION(S) BELOW

The opinion of the United States District Court for the District of Kansas in the case of Stagner v. United States Patent and Trademark Office granting Summary Judgment against the plaintiff on June 29, 1989, appears in 11 USPQ2d 1553 (D. Kan. 1989) and is included in Joint Appendix (separate) and the January 25, 1990, opinion of the United States Court of Appeals for the Federal Circuit, affirmed the June 29, 1989, Summary Judgment United States District Court for the District of Kansas in the case of Stagner v. United States Patent and Trademark Office, which has not been prepared for publication in a printed volume and will appear in the tables published periodically, and is included in Joint Appendix (separate).

JURISDICTION

The June 29, 1989 Summary Judgement, Memorandum and Order of the United States District Court for the District of Kansas, that was affirmed by Decision of the United States Court of Appeals for the Federal Circuit by Circuit Judge, ARCHER, Senior Circuit Judge, COWEN and Circuit Judge, MAYER entered on January 25, 1990, in this case and the Supreme Court should exercise jurisdiction herein.

The jurisdiction of the Supreme Court is invoked under the provisions of Title 28 USC 1254(1), 28 USC 2101, 28 USC 2103, 28 USC 2106 & 28 USC 2108.

Cases that sustain the jurisdiction of this Court include:

Kerr v. United States Dist. Court for the Northern Dist., 426 US 394, 48 L Ed 2d 725, 96 S Ct. 2119.

Louisiana Public Service Comm. v. FCC (1986, US) 90 L Ed 2d 369, 106 S Ct 1890.

Right to remedy of certiorari in the United States Supreme Court is Provided by federal law. U. S. ex rel. Smith v. Nelson, D.C. Cal. 1967, 275 F. Supp. 261.

Petite v. U. S., C. A.Md. 1959, 262 F.2d 788, remanded on other grounds 80 S. Ct. 450, 361 U.S. 529, 4 L.Ed. 2d 490.

Pursuant to Rules 10, 12, 13 and 14 of the Rules of the Supreme Court of the United States, Petitioner, Pro Se, Irvin D. Stagner, files this statement of the basis upon which it is contended that the Supreme Court of the United States has jurisdiction to review the final the June 29, 1989, Summary Judgement, Memorandum and Order of the United States District Court for the District of Kansas, that was affirmed by Decision of the United States Court of Appeals for the Federal Circuit and entered on January 25, 1990, by Circuit Judge, ARCHER, Senior Circuit Judge, COWEN and

Circuit Judge, MAYER.

This appeal arises from an action to the case of Stagner v. United States Patent and Trademark Office that was filed in the United States District Court for the District of Kansas, with jurisdiction of that Court under 35 USC 141 & 35 USC 145, 37 CFR 1.113 & 37 CFR 1.181 and 28 USC 1291, 28 USC 1338, 28 USC 1361, 28 USC 1391 and 28 USC 1631, Tile 5 USC 500-706 and the Fifth Amendment of the United States Constitution.

The Summary Judgment of the United States District Court for the District of Kansas was entered on June 29, 1989, whereas, the United States Court of Appeals for the Tenth Circuit is the appeal court for the United States District Court for the District of Kansas, a timely notice of appeal to the United States Court of Appeals for the Tenth Circuit was entered on July 17, 1989, in the United States District

Court for the District of Kansas. The United States Court of Appeals for the Tenth Circuit transferred the case to the United States Court of Appeals for the Federal Circuit on September 5, 1989. The case was placed on the docket of the United States Court of Appeals for the Federal Circuit on September 15, 1989, with jurisdiction under 35 USC 141 & 35 USC 145, 37 CFR 1.113 & 37 CFR 1.181 and 28 USC 1291 & 28 USC 1295.

CONSTITUTIONAL AND STATUTES INVOLVED

FIFTH AMENDMENT OF THE
UNITED STATES CONSTITUTION
AND DUE PROCESS.

Title 5 USCA 500-706.
ADMINISTRATIVE PROCEDURE ACT.
FOR REVIEW OF A RECORD MADE
BEFORE A ADMINISTRATIVE AGENCY.

For verbatim see Joint Appendix

TITLE 28 USCA.
RULES OF PRACTICE OF THE UNITED
STATES DISTRICT COURT FOR THE
DISTRICT OF KANSAS
RULE 16 (a), (b) and (c #3).

35 USCA 101.
INVENTIONS PATENTABLE.

35 USCA 102.
CONDITIONS FOR PATENTABILITY;
NOVELTY AND LOSS OF RIGHT.

35 USCA 103.
CONDITIONS FOR PATENTABILITY;
NON-OBVIOUS SUBJECT MATTER.

35 USCA 141.
APPEAL TO COURT OF APPEALS
FOR THE FEDERAL CIRCUIT.

35 USCA 145.
CIVIL ACTION TO OBTAIN
A PATENT.

37 CFR 1.104.
NATURE OF EXAMINATION;
EXAMINERS ACTION.

37 CFR 1.105.
COMPLETENESS OF EXAMINER'S
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37 CFR 1.106.
REJECTION OF CLAIMS.

37 CFR 1.107.
CITATION OF REFERENCES.

37 CFR 1.113.
FINAL REJECTION OR ACTION.

37 CFR 1.181.
PETITION TO THE COMMISSIONER.

37 CFR 1.191.
APPEAL TO THE BOARD OF
APPEALS

STATEMENT OF CASE

The plaintiff filed applications for three different types of tools which are as follows:

A Ratchet Extension.

Case NO. 87-1713K.

(see administrative record pages 1552, 1608, 1952 and 2166).

A set of Wrench Extensions.

CASE NO. 87-1714K.

(see administrative record pages 0768, 0818, 1191 and 1400).

A combined set of 45 Degree and 90 Degree Angled Socket Extensions.

CASE NO. 87-1715K.

(see administrative record pages 0004, 0057, 0401 and 0636).

There were four Continue In Part Applications filed on each of the three tools.

The first application on each of the three tools did not met the format requirements of 35 . USCA 112 (see

administrative record pages 0004, 0768 and 1552).

Starting with the second application on each of the three tools the Examiner was unreasonable, unfair, arbitrary, capricious and breached constitutional due process of the Fifth Amendment of the Constitution of the United States, in his action, did not comply with the 35 USCA 101, 35 USCA 102, 35 USCA 103, 37 CFR 1.104, 37 CFR 1.105, 37 CFR 1.106, 37 CFR 1.107, (see administrative record pages 0057, 0818 and 1608) (see administrative record pages 0058 & 0146, 0855 & 0933 and 1650 & 1716),

In reference to the Opinion issued by the United States Court of Appeals for the Federal Circuit, page 3 lines 40-41 of the Opinion in which it states that the suits in district court were premature because the fourth application is still pending and without any assured changes in procedure the fourth

application could be rejected by the Examiner and that the applicant can seek judicial review pursuant to either 35 U.S.C. 141 or 145.

The Fourth Application cannot be subject to the Board Of Appeals and 37 CFR 1.191, whereas, the Fourth Application has the (CIP) CONTINUATION IN PART established under 35 USC 120 and 37 CFR 1.60 the CIP attaches the Fourth Application from the First Rejection of the First Application through First Rejection of the Fourth Application giving right to bring the suit in District Court.

The Defendants Decisions on each of the 37 CFR 1.181 Petitions to the Commissioner, have responded as though the Application was one Application that is, from the First Application through the First Action on the Fourth Application and said that the Application was subject to the Board Of Appeals, which is not true as the issue

as raised by the applicant is procedure not merit as the Defendants have stated and it has not mattered to the Defendants if the 37 CFR 1.181 Petitions to the Commissioner was filed, after the first action, after the second action or after the third action or with a new CIP Application when filed.

Therefore and because of the response to the Petitions to the Commissioner were always treated the same which was based on the merit issue and not the procedure issue as raised by the applicant, the decisions to the 37 CFR 1.181 Petitions to the Commissioner, the Defendants has treated the CIP Applications as ONE CONTINUOUS APPLICATION, therefore, the DECISION And OPINION OF THE UNITED STATES COURT OF APPEALS for the FEDERAL CIRCUIT in trying to support by AFFIRMING the SUMMARY JUDGMENT MEMORANDUM and ORDER of the DISTRICT COURT for the DISTRICT of KANSAS, the DECISION and the OPINION of

the UNITED STATES COURT of APPEALS for the FEDERAL CIRCUIT which states that the SUIT IN DISTRICT COURT WAS PREMATURE, is a RULING THAT RULES THAT THE DEFENDANTS ARE WRONG in the Decisions on the Petitions to the Commissioner.

In fact, the UNITED STATES COURT OF APPEALS for the FEDERAL CIRCUIT in its Decision to affirm the Summary Judgment, is no more than a effort to find for the Defendants but in fact ruled the Defendants are wrong in the Decisions to the 37 CFR 1.181 Petitions to the Commissioner and the APPEALS COURT never really looked into the facts to see what the true facts are.

The facts are that after one application has been once or twice rejected by the examiner, the applicant can turn to 37 CFR 1.113. (see appendix for 60 Am Jur 2d page 400 Section 495), for questions of prematureness of final rejection should be raised while the

case is reviewable by PETITION TO THE COMMISSIONER and see references 45, 46, 47 and 48).

A petition to the Commissioner under 37 CFR 1.181 may be taken to the Commissioner from ANY ACTION OR ANY REQUIREMENT OF A PATENT EXAMINER IN THE EX PARTE PROSECUTION OF A APPLICATION. (See appendix for 60 Am Jur pages 434 and 435, for PETITION TO THE COMMISSIONER A. In General Sections 566-571).

There is not one statute or Code of Federal regulations that requires a applicant to file three or four applications before a suit can be filed in the district court, (the requirement is, one application once or twice rejected) 37 CFR 1.113 gives a choice of 37 CFR 1.191 for merit issues through the Board of Appeals and choice of 37 CFR 1.181 for procedure issues and a petition to the Commissioner as the board of Appeals cannot take up the

procedure issues.

After one application is twice rejected by the Examiner and the applicant has procedure problem with the Examiner then he is required to file a petition to the Commissioner for correction of the procedure problem under 37 CFR 1.181 and if the procedure problem is not corrected by the petition to the Commissioner then after one petition (that is, one, not several petitions) to the Commissioner has not brought about a correction of the procedure problem then by 35 U.S.C. 141 and 145 the applicant may filed suit in District Court were he resides.

The suit can be filed in accordance to 60 Am Jur 2d page 437 starting with B. Judicial Review of the Commissioners Decisions (sections 572-575). 60 Am Jur 2d B. and the research references are 35 USCS 141.

60 Am Jur 2d section 572 Jurisdiction of District Court and names the Court of for the Federal Circuit as the appeal Court. Re Makari (Ca FC) 708 F2d 709, 218 USPQ 193

60 Am Jur 2d section 573 Review by the way mandamus. that the Decisions of the Commissioner of Patents are reviewable in district Court by mandamus. Application of Mindick, 54 Cust & Pat App 1053, 371 F2d 892.

Application of Wiechert, 54 CCPA 957, 370 F2d 927, 152 USPQ 247.

60 Am Jur 2d section 574 Review under Administrative procedure Act Title 5 USCS section 701.

60 Am Jur 2d section 575 What determinations are reviewable. Mandamus will lie or an action under the Administrative Procedure Act and to compel him to sign a Patent. Butterworth V. United States, 112 US 50, 28 L Ed 656, 5 S Ct 25.

THE FIRST SPECIFIC BREACH OF ADMINISTRATIVE PROCEDURE

The first specific breach of Administrative Procedure in the Administrative Record, by the defendants was in the first action by the Examiner of the second application in which the Examiner was unreasonable, unfair, arbitrary, capricious and breached constitutional due process of the Fifth Amendment of the Constitution of the United States, (See first Action and Administrative Record pages 0085-0086, 0789-0791 and 1579-1581). The specific breach of administrative procedure is as follows:

The Examiners action did not comply with the following Code of Federal Regulations:

37 CFR 1.104, NATURE OF EXAMINATION; EXAMINERS ACTION

37 CFR 1.105, COMPLETENESS OF EXAMINER'S ACTION

37 CFR 1.106, REJECTION OF CLAIMS

37 CFR 1.107. CITATION OF REFERENCES

In his first and second action the examiner never made a thorough study thereof and never made a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The Examiner's action was not a complete examination with respect both to compliance of the application with the applicable statutes and rules, (case law).

While the Examiner applied his interpretation of prior art in his actions and rejected the claim under his interpretation of statute 35 U.S.C. 103 (obviousness), the Examiner did not support his interpretation of 35 U.S.C. 103 in accordance with the cases under 35 U.S.C. 103 as required by the manual of Patent procedure page 1 of the Introduction and the paragraph on Decisions which States as follows:

> "In addition to the statutory regulations, the actions taken by the examiner in the examination of applications for patents are to the great extent governed by decisions on prior cases."

The Examiner in his action never responded to the cases cited by the applicant in the Examiner's argument for nonpatentability.

Therefore his the Examiners action was not complete nor thorough and did not comply with 37 CFR 1.104.

The Examiner's premature action did not comply with 37 CFR 1.105, whereas, 37 CFR 1.105 states that the examiner's action will be complete as to all matters and the Examiner did not complete a examination with reference to all matters when his action did not include the a decision based on the citing cases under 35 U.S.C. 103 nor reference to the cases cited by the applicant.

The Examiner's action did not comply with 37 CFR 1.106(b) that states,

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. Moreover, the Examiner never cited the best references at his command because he never cited any case at all which cannot be the best references at his command.

The Examiner never responded to the applicants calling for the examiner to cite any specific facts of his interpretation of 35 U.S.C. 103 (obviousness) and in view of the cases submitted into the applications by the applicant and by not supporting his action by citing the cases was in violation of 37 CFR 1.107.

To be complete to all matters and to make a thorough examination the Examiner would have had to respond to the following subject matter in the cases cited by the plaintiff in the rebuttals and amendments, without responding to the cases the Examiner did

not make a thorough study and a complete examination as to all subject matter in the applications.

The Examiner did not comply with the Courts interpretation of 35 U.S.C. 112, 35 U.S.C. 101, 35 U.S.C. 102 and 35 U.S.C. 103 because his interpretation of those statutes are different than the courts and the decisions by case law.

The following subject matter that pertains to obviousness and are included in the cases which are not the same as the Examiners interpretation as to obviousness.

#1 What is obviousness as defined by patent statutes and rules, case law?

#2 What is nonobviousness as defined by patent statutes and rules, case law?

#3 What is mere mechanical skill as defined by patent statutes and rules?

#4 How should prior art be read when making a inquiry into a what level of skill was involved in the creation of the invention at issue?.

#5 Who is the person of ordinary skill?

#6 Should the examiners substitute themselves for the person of ordinary of skill?

#7 What is unexpected properties?

#8 What is Synergistic effect?

#9 What is anticipation as defined by patent statutes and rules?

#10 What is hindsight and foresight as defined by patent statutes and rules?

#11 Is modifying or combining features of prior art to bring about a new combination of old elements invention when a new mode or operation is produced and does this sustain a patentable invention as defined by patent statutes and rules?

#12 Can a little modification sustain a patent or must a little modification negate patentability as defined by patent statutes and rules?

#13 What is prima facie obviousness; how is a prima facie case of obviousness established, what is required by the

applicant if a prima facie case of obviousness is established, how can a prima facie case rebutted, is a prima facie case of obvious a fact?

#14 Can a patent be obtained if all of the elements in an application are found in prior art or in several prior art patents?

#15 What is a ex parte examination?

#16 What is a "afterseen" obviousness?

#17 How much physical change or how little physical is needed or required to sustain a patent?

#18 Is it legal to read into prior art the disclosure in a patent application?

#19 What is the effect of each of the prior patents or publications four corners on an application for patent issue?

#20 Will combining of elements in different prior art prevent invention?

#21 Is prima facie obviousness a fact?

#22 Can a simple solution to a problem be invention?

#23 How much or how little or how slight change in old construction add still constitute invention?

#24 How much physical change is needed to be invention?

#25 Will simplicity of operation deny a patent?

The above examples are only some of the subject matter that the examiner must address to be complete to all matters, and to make a thorough examination of a application.

An Amendment was filed October 15, 1985, (See administrative record for the Amendment on pages 0098, 0876 and 1677), by the plaintiff which specifically pointed out the errors of the Examiner's First Action in accordance with 37 CFR 1.111 and 37 CFR 1.112 and was supported by cases that have the Courts interpretations as to what how and why 35 USCA 112, 35 USCA 102 and 35 USCA 103 is interpretated which is not the same as the Examiner's interpretation of

those statutes. Whereas, the act of interpretation of a statute is not "MERIT" but is a action which is "PROCEDURE" as defined by any dictionary.

The Amendment filed October 15, 1985 is as follows:

Pages 0098 and 0099 is a rewritten claim in accordance with 37 CFR 1.111, 37 CFR 1.112, 37 CFR 1.118 and 35 U.S.C. 132.

The Amendment pages 0100 through 0104 are to explain the changes to be made in the text to comply with 35 U.S.C. 112.

The Amendment pages 0105 through 0117 are to cite the cases that are under 35 U.S.C. 101, 35 U.S.C. 102 and 35 U.S.C. 103 and 35 U.S.C. 112 that are closely related in subject matter that proves that the rejection of the claim was improper and the used only his own interpretation of those statues.

Starting with Amendment pages 0118 through 0124 the exact wording of the

cases cited on pages 0105 through 0117 only with connective words added between the cases, in which the cases are so closely related that a person reading the cases would not know that the words are a way to connect the cases into larger paragraphs.

The exact wording of cases by the courts with connective words are repeated on pages 0125 through 0135 and applied to the invention to which the amendment was prepared.

The amendment concluded with the concluding argument on pages 0135 and 0136 with a request for reconsideration for letters patent issue.

The Defendants have never read the amendments or rebuttals for they would have known that the cases cited were applied to the invention that the amendment was prepared. in the amendment of October 15, 1985 that is on pages 0085-0087 is the 45 Degree and 90 Degree Angled Socket Extension Set, Serial No.

6,671,168 in which the cases cited by the applicant was applied to the invention.

The plaintiff has made a complete and thorough study of not only prior art as the Examiner did but also, a complete and thorough study of the Rules and Statutes with a complete study of the cases under the above cited Statutes.

Every application, every rebuttal and every amendment filed by the applicant on/or after October 15, 1985 repeated the complete and thorough response to the examiner's action in the same manner as the amendment cited above.

Every action by the Examiners after October 15, 1985 was a repeat of the same rejection as though the applicant had never responded to any of the rejections and the breach of administrative due process was repeated without any response to the procedure change requested by the applicant.

By the use of 37 CFR 1.113 the

applicant was in pursuant to 37 CFR 1.181, Petition to the Commissioner of Patents for review of the Examiner's examining procedure by the Commissioner's Supervisors, (see administrative record pages 0149, 0936 and 1719), however the procedure used by the commissioner's Supervisiors did not review the Examiner's examining procedure, instead, reviewed if the examiner had made a rejection, (see administrative record page 0257).

All the Petitions to the Commissioner under 37 CFR 1.113 and 37 CFR 1.181 have been answered in the same manner without response to the Statutes, Rules and cases where the purpose of the petitions have been ignored.

In answer to the Petitions to the Commissioner the Defendants refuse to read 37 CFR 1.113 as written and applied their own answer to what 37 CFR 1.113 and 37 CFR 1.181 means and how they are to be used, whereby, the Defendants did

not and do not make the correct demarcation between the two Channels of Ex Parte Review as shown and written on page 1200-1 of the Manual of Patent Examining Procedure.

Whereas, 37 CFR 1.113(a) states that, On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (1.191), or to amendment as specified in 1.116.

Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (1.181).

Starting with 37 CFR 1.113 where there is a clear line of demarcation between the use of 37 CFR 1.191 or the use of 37 CFR 1.181 by the word -----OR---- which gives a choice of one or the other 37 CFR 1.191 or 37 CFR

1.181 but both are not to be used.

The Defendants in the response to the Petitions to the Commissioner read 37 CFR 1.113 without the -------OR----then state that there is not any line of demarcation set in 37 CFR 1.113 and the only requirement is the use of 37 CFR 1.191 which is only true if the is not any required procedure at all and the Examiners can do as they please and are not required to limit the examination to the statutes and rule.

The prior printing of page 1200-1 of the Manual of Patent Examining Procedure has the drawing of the two Channels of Ex Parte Review but the current Manual does not show the drawing, however, the Statutes and Rules did not change and the two Channels of Ex Parte Review are the same as when the drawing was shown in the manual.

In the application of 37 CFR 1.113,

37 CFR 1.181, and 37 CFR 1.191 and the line of demarcation between procedure issues and merit issues the Channels of Ex Parte Review as set forth in the Manual of Patent Examining Procedure page 1200-1, in which the the drawing of the the Channels of Ex Parte Review shows clearly the line of demarcation between the two Channels of Ex Parte Review, Procedure and merit.

When the use of 37 CFR 1.113, 37 CFR 1.181 and a Petition to the Commissioner the applicant is required to repeat the application to the Examiner at the same time as the Petition to the Commissioner as stated in 37 CFR 1.181(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution for an application, it may be required that there have been a proper request for reconsideration (1.111) and a repeated action by the examiner.

A SPECIFIC BREACH OF ADMINISTRATIVE DUE PROCESS

On July 22, 1988 a letter was mailed to the applicant to try to claim that the Fourth CIP Application was not copending with the Third CIP Application, However that letter was in error as the Defendants did not take any action at all in EIGHT MONTHS (8) on the third CIP Application Serial No. 873,504, in which the second action by the Examiner was due in sixty days (60) from the date the applicant filed the amendment to the Examiner's first action, there was not any response to at all in the eight months by the defendants which constitutes a breach of Due Process

THE SUMMARY JUDGMENT OF DISTRICT COURT FOR THE DISTRICT OF KANSAS

The Summary Judgment, Memorandum and Order of District Court for the District of Kansas entered on June 29, 1989, in which the opinion is not supported by the findings of fact and is contrary to the applicable law, and in violation of Title 28 USCA, Rule 16(a), (b) and (c #3) and was inappropriately based on limited and timed hearings without a trial which is inappropriate.

Title 28 USCA Rule 16(a), (b) and (c #3) states that scheduling pretrial conferences are inappropriate when the complaint is filed to review administrative actions on the record made before the administrative agency in accordance with Title 5 USCA 500-706 (See, 60 Am Jur 2d page 437 starting with B. Judicial Review of the Commissioners Decisions, sections 572-575 by the way of 35 USCS 141) and

the review of ADMINISTRATIVE PROCEDURE where jurisdiction and venue is under 28 USCA 1338, 28 USCA 1361, 28 USCA 1391 and Title 35 USCA 102, 35 USCA 103, 37 CFR 1.113, 37 CFR 1.181 and The Fifth Amendment of the United States Constitution and where the complex matters of the case can only be resolved by appropriate trail.

The District Court for the District of Kansas on June 29 1989, was in violation of Title 28 USCA and rule 16(a), (b) and (c) by holding hearings that was so limited in time, that the limited time never allowed for bringing out the proof of the violation of the laws in the case and the facts can only be resolved holding a trial as the plaintiff's complaints was filed to review by trial, the Patent and Trademarks Office administrative procedures used to examine the plaintiff's application and record filed in the Patent Office.

The summary judgment, memorandum and order violated Title 35 USCA and 37 CFR 1.113 and 37 CFR 1.181, as well as, Title 5 USCA 500-706, whereby, the plaintiff has filed for review by trial the administrative procedure used by the defendants to examine the plaintiff's applications and the District Court only reviewed the merit issue, whereupon, The facts on which petitioner relies for obtaining the relief sought herein are as follows:

1. The Summary Judgment and Order by the District Court for the District of Kansas filed June 29, 1989 wrongly construed the complaints and amended complaints filed by the plaintiff against the defendants into a merit issue from a clear procedure issue as filed by the plaintiff.

2. Whereby, the Court in the summary judgment, memorandum and order made a issue of merit and a decision of merit issue, instead of a issue of

procedure and a decision of procedure issue which is in violation of Title 35 USCA 141, 35 USCA 102, 35 USCA 103, 37 CFR 1.113, 37 CFR 1.191, 37 CFR 1.181 and the Manual of Patent and Examining Procedure page 1200-1. (See, 60 Am Jur 2d page 437 starting with B. Judicial Review of the Commissioners Decisions, sections 572-575).

3. A issue of merit can only be considered and a decision of merit be made by the the Board of Appeals or the Appeals to Court of Appeals for the Federal Circuit 35 USCA 141, or by the Civil Action in the District Court for the District of Columbia 35 USCA 145 and 5 USCA 704, whereas, the Board of Appeals cannot take up the issue of procedure.

4. Whereas, the Summary Judgment did not address the Procedure issue as filed in the Complaints and Amended Complaints by the plaintiff the Court did violate the Fifth Amendment of the

United States, and Due Process.

5. By accepting a merit issue as a defense from the defendants into the District Court for the District of Kansas, the Court allowed the issue of merit to be entered in the Court in violation of 37 CFR 1.113, 37 CFR 1.181 and the Patent Examining Procedure Manual page 1200-1 as the Congress of the United States wrote into those statutes a line of demarcation between procedure issues and merit issues and explained on page 1200-1 of the Manual of Patent Examining Procedure.

6. The Court did not follow the line of demarcation between procedure issues and merit issues as set forth in the Manual of Patent Examining Procedure page 1200-1, 37 CFR 1.191 (merit issues) and 37 CFR 1.181 (procedure issues) but allowed the defendants statements, stating that there is not any line of demarcation between the procedure issues and merit issues and the Court allowed

the defendants statements that procedure issues and merit issues are not separable whereas, the two issues are clearly separable as set forth by Congress, thereby the summary judgment, memorandum and order entered by the court June 29 1989 was in violation of the aforementioned statutes.

7. Whereas, the plaintiff had correctly followed the line of demarcation (37 CFR 1.113) between procedure issues (37 CFR 1.181) and merit issues (37 CFR 1.191 and review by the Board of Appeals was not filed) and correctly filed a complaint in the District Court For The District of Kansas, Civil action against the Commissioner of Patents, Judicial Review (Procedure Issues) under Title 35 USCA 141, 37 CFR 145, Title 5 USCA 500-706 and The Fifth Amendment of The Constitution of The United States, Jurisdiction and Venue for the District Court For The District of Kansas, by the

way of Mandamus has been covered properly in the Plaintiff's Complaint.

THE OPINION AND RULING THE
UNITED STATES COURT OF
APPEALS FOR THE CIRCUIT

In reference to pages 1 and 2, lines 1-5 of the Opinion.

> "The present action arises from a lenghty history of patent prosecution in the United States Patent and Trademark Office (PTO) by the appellant, proceeding Pro Se. Following the PTO proceedings, he filed three civil actions in the United States District Court for the District of Kansas."

In reference to page 2, lines 8-9 of the Opinion.

> "Since Mr. Stagner failed exhaust his administrative remedies,.."

And in reference to page 3, lines 40-41

of the Opinion.

"Although Mr. Stagner's suits in the district court were premature, ..."

And in reference to page 3, lines 45-49 of the Opinion.

"His fourth patent patent application is still pending in the PTO. If it is finally rejected by the examiner, he can appeal within the PTO and of dissatisfied with that decision, he can seek judicial review pursuant to either 35 U.S.C. section 141 or 145."

And in reference to page 3, lines 38-40 of the Opinion.

"Thus, Mr. Stagner's disputes with the examiner's grounds for rejection are disputes on merit of his applications."

The Summary Judgment by the District court and the opinion of the United States Court of Appeals for the

federal Circuit are based on a MERIT ISSUE which is not legal by the statutes 35 U.S.C. 141, 37 CFR 1.113, 37 CFR 1.181 and the Manual of Patent Examining Procedure page 1200-1. (See, 60 Am Jur 2d page 437 starting with B. Judicial Review of the Commissioners Decisions, sections 572-575).

A issue of merit can only be considered and a decision of merit be made by the the Board of Appeals or the Appeals to Court of Appeals for the Federal Circuit 35 USCA 141, or by the Civil Action in the District Court for the District of Columbia 35 USCA 145 and 5 USCA 704, whereas, the Board of Appeals cannot take up the issue of procedure.

By affirming the District Court Summary Judgment the opinion of the United States Court of Appeals for the federal Circuit accepted a merit issue as a defense from the defendants into the District Court for the District of

Kansas, the Court allowed the issue of merit to be entered in the Court in violation of 37 CFR 1.113, 37 CFR 1.181 and the Patent Examining Procedure Manual page 1200-1 as the Congress of the United States wrote into those statutes a line of demarcation between procedure issues and merit issues and explained on page 1200-1 of the Manual of Patent Examining Procedure.

After one application has been twice rejected by the examiner, the applicant can turn to 37 CFR 1.113.

There is not one Statute or Code of Federal regulations that requires a applicant to file three or four applications before a suit can be filed in the district court, (the requirement is, one application twice rejected) 37 CFR 1.113 gives a choice of 37 CFR 1.191 for merit issues through the Board of Appeals and choice of 37 CFR 1.181 for procedure issues and a petition to the Commissioner as the board of Appeals

cannot take up the procedure issues.

After one application is twice rejected by the Examiner and the applicant has procedure problem with the Examiner then he is required to file a petition to the commissioner for correction of the procedure problem under 37 CFR 1.181 and if the procedure problem is not corrected by the petition to the Commissioner then after one petition (that is, one, not several petitions) to the commissioner has not brought about a correction of the procedure problem then by 35 U.S.C. 141 and 145 the applicant may filed suit in District Court were he resides.

The fact is that the statements, a lenghty history of patent prosecution in the PTO by the appellant, and Mr, Stagner's Suits in the district court were premature, are contrary, one to the other and both cannot be true, in which the statement that, the suites in district court were premature, is is not

the correct statement.

In reference to page 3, lines 44-45 of the Opinion.

> "Finally, we note that our decision in this appeal dose not leave Mr. Stagner without remedy."

The only remedy that is available to a applicant of patent to correct a wrong procedure starts with a petition to the Commissioner by the way of 37 CFR 1.113 and 37 CFR 1.181 and then if the wrong procedure is not corrected by the Commissioner the the next step is to file suit in the district court by the way of 35 U.S.C. 141. (See, 60 Am Jur 2d page 437 starting with B. Judicial Review of the Commissioners Decisions, sections 572-575).

REASONS FOR GRANTING WRIT

The Supreme Court should grant the Petitioner a writ of certiorari issue to review the June 29, 1989, Summary Judgement, Memorandum and Order of the United States District Court for the District of Kansas, that was affirmed by Decision of the United States Court of Appeals for the Federal Circuit and entered on January 25, 1990.

The Decision and Opinion of the United States Court of Appeals for the Federal Circuit has a "Note" at the top of first page.

"This opinion has not been prepared for publication....and is not of widespread legal interest. ...."

While this case has not had any publicity to cause it to have widespread legal interest and public interest, there is widespread legal and public interest in the Administrative Procedure used by the Patent and Trademark Office

in the examination of patents. In fact a short time ago, there were some members United State Congress that publicly complained about the Administrative Procedure used by the Patent Office in the examination of patent applications.

Therefore, this case being the first case in some time to come before the Supreme Court with complaints about the Administrative Procedure used by the Patent Office in the examination of patent applications the Supreme court should grant the writ for the certiorari and review this case.

Congress separated by a line of demarcation (37 CFR 1.113) into two remedies for disputes in the examination of patent applications, one merit of the invention (37 CFR 1.191) and the other Administrative procedure used in the examination of patent application (37 CFR 1.181). This case was filed in the District Court for the District of

Kansas in accordance with 37 CFR 1.113, 37 CFR 1.181, 35 USCA 141 and 35 USCA 145 Title 5 USCA 500-706 and the Due Process of the Fifth Amendment of the Constitution, for review of the the Patent and Trademark Administrative Procedure in the examination of patents and then a defense of merit was entered only as a way to avoid the review of patent Administrative Procedure used in the examination of these applications.

The Fourth Application cannot be subject to the Board Of Appeals and 37 CFR 1.191, whereas, the Fourth Application has the (CIP) CONTINUATION IN PART established under 35 USC 120 and 37 CFR 1.60 the CIP attaches the Fourth Application from the First Rejection of the First Application through First Rejection of the Fourth Application giving right to bring the suit in District Court.

The Defendants Decisions on each of the 37 CFR 1.181 Petitions on the

Commissioner, have responded as though the Application was one Application, that is, from the First Application through the First Action on the Fourth Application and said that the Application was subject to the Board Of Appeals, which is not true as the issue as raised by the applicant is procedure not merit as the Defendants have stated and it has not mattered to the Defendants if the 37 CFR 1.181 Petitions to the Commissioner was filed, after the first action, after the second action or after the third action or with a new CIP Application when filed, the response to the petitions to the Commissioner were always the same which was based on merit issue not the procedure issue raised by the applicant.

Therefore and because of the decisions to the 37 CFR 1.181 Petitions to the Commissioner, the Defendants has treated the CIP Applications as ONE CONTINUOUS APPLICATION, therefore, the DECISION

OPINION OF THE UNITED STATES COURT OF APPEALS for the FEDERAL CIRCUIT in trying to support by AFFIRMING the SUMMARY JUDGMENT MEMORANDUM and ORDER of the DISTRICT COURT for the DISTRICT of KANSAS, the DECISION and the OPINION of the UNITED STATES COURT of APPEALS for the FEDERAL CIRCUIT, which states, that the SUIT IN DISTRICT COURT WAS PREMATURE is a RULING THAT RULES THAT THE DEFENDANTS ARE WRONG in the Decisions to the Petitions to the Commissioner.

In fact, the UNITED STATES COURT OF APPEALS for the FEDERAL CIRCUIT in its Decision to Affirm the Summary Judgment, is no more than a effort to find for the Defendants but in fact ruled the Defendants are wrong in the Decisions to the 37 CFR 1.181 Petitions to the Commissioner and the APPEALS COURT never really looked into the facts to see what the true facts are.

The facts are that after one application has been once or twice rejected by the

examiner, the applicant can turn to 37 CFR 1.113. (see appendix for 60 Am Jur 2d page 400 Section 495), for questions of prematureness of final rejection should be raised while the case is reviewable by PETITION TO THE COMMISSIONER and see references 45, 46, 47 and 48).

A petition to the Commissioner under 37 CFR 1.181 may be taken to the Commissioner from ANY ACTION OR ANY REQUIREMENT OF A PATENT EXAMINER IN THE EX PARTE PROSECUTION OF A APPLICATION. (See appendix for 60 Am Jur pages 434 and 435, for PETITION TO THE COMMISSIONER A. In General Sections 566-571).

The suit can be filed in accordance to 60 Am Jur 2d page 437 starting with B. Judicial Review of the Commissioners Decisions (sections 572-575). 60 Am Jur 2d B. and the research references are 35 USCS 141.

60 Am Jur 2d section 572 Jurisdiction of

District Court and names the Court of for the Federal Circuit as the appeal Court. Re Makari (Ca FC) 708 F2d 709, 218 USPQ 193

60 Am Jur 2d section 573 Review by the way mandamus. that the Decisions of the Commissioner of Patents are reviewable in district Court by mandamus. Application of Mindick, 54 Cust & Pat App 1053, 371 F2d 892.

Application of Wiechert, 54 CCPA 957, 370 F2d 927, 152 USPQ 247.

60 Am Jur 2d section 574 Review under Administrative procedure Act Title 5 USCS section 701.

60 Am Jur 2d section 575 What determinations are reviewable. Mandamus will lie or an action under the Administrative Procedure Act and to compel him to sign a Patent. Butterworth V. United States, 112 US 50, 28 L Ed 656, 5 S Ct 25.

The patent examiners that examined the

applications in this case had a interpretation of 35 USC 103 and what obviousness is that separate from the cases in reference under 35 USC 103.

The Examiners did not comply with the Courts interpretation of 35 U.S.C. 112, 35 U.S.C. 101, 35 U.S.C. 102 and 35 U.S.C. 103 because their interpretation of those statutes are different than the courts and the decisions by case law.

Therefore the Examiners not comply with 37 CFR 1.104, 37 CFR 1.105, 37 CFR 1.106, 37 CFR 1.107, (see administrative record pages 0057, 0818 and 1608) (see administrative record pages 0058 & 0146, 0855 & 0933 and 1650 & 1716).

By the District court allowing a merit issue for a defense of a Administrative Procedure issue and issuing the District Court Summary Judgment the Decision and Opinion of the United States Court of Appeals for the federal Circuit affirming a merit issue as a defense from the defendants into the District

Court for the District of Kansas, both Courts allowed the issue of merit to be entered in the Court in violation of 37 CFR 1.113, 37 CFR 1.181 and the Patent Examining Procedure Manual page 1200-1 as the Congress of the United States wrote into those statutes a line of demarcation between procedure issues and merit issues and explained on page 1200-1 of the Manual of Patent Examining Procedure.

After one application has been twice rejected by the examiner, the applicant can turn to 37 CFR 1.113.

There is not one statute or Code of Federal regulations that requires a applicant to file three or four applications before a suit can be filed in the district court, (the requirement is, one application once or twice rejected) 37 CFR 1.113 gives a choice of 37 CFR 1.191 for merit issues through the Board of Appeals and choice of 37 CFR 1.181 for procedure issues and a

petition to the Commissioner as the board of Appeals cannot take up the procedure issues.

After one application is twice rejected by the Examiner and the applicant has procedure problem with the Examiner then he is required to file a petition to the Commissioner for correction of the procedure problem under 37 CFR 1.181 and if the procedure problem is not corrected by the petition to the Commissioner then after one petition (that is, one, not several petitions) to the Commissioner has not brought about a correction of the procedure problem then by 35 U.S.C. 141 and 145 the applicant may filed suit in District Court were he resides.

The fact is that the statements in the Decision and Opinion of the United States Court of Appeals for the Federal Circuit, "a lenghty history of patent prosecution in the PTO by the appellant", and "Mr, Stagner's Suits in

the district court were premature", are contrary, one to the other and both cannot be true, in which the statement that, the suites in district court were premature, is is not the correct statement.

The District Court by holding hearings that was limited to very short time limit did not give the Plaintiff time to prove facts of the case and to show cause, and the District Court was in violation of 28 USC Rule 16(a), (b), (c #3) of the Rules of Practice for the District court for the District of Kansas, in holdings hearings and not reviewing by trial a Administrative record made before a United States Government Agency and the breach of Due Process of the Fifth Amendment of the Constitution United States.

The District Court did rely on:

> McKenzie v. Mercy Hospital, 854 F,2d 365, 367, (10th Cir. 1988)

to examine all evidence in a light most favorable to the Patent and Trademark

Office, in which the case cited does not involve any government agency but is civil case only, whereas, the District Court should have been a watch dog over a government agency as the following cited case proves:

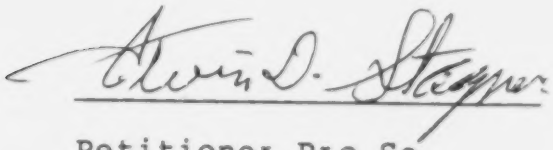
> Title 5 USC 706, Note 22
> Duty of Court
> District court has duty to stand watch dog for any procedural due process deficiencies on part of administrative agency adversely affecting any party. Pre-Fab Transit Co. v. U.S., D.C.Ill.1969, 306 F.Supp. 1247, affirmed 90 S.Ct. 815, 397 U.S. 40, 25 L.Ed.2d 41.

There has been protest by both the Defendants and the District Court to the point of being prejudice, first in the Decisions to the 37 CFR 1,181 Petitions to the Commissioner that a Pro Se is applying for patent issue in his own applications and second, in the District Court as stated in the Summary Judgment, memorandum and Order of the District Court that a Pro se is asking to conduct his own case in a trial court under 28 USC 1654, without counsel and that

prejudiced attitude has governed the decisions of this case.

For the foregoing reasons this petition for a writ of certiorari should be granted.

Respectfully submitted,



Petitioner Pro Se

Irvin D. Stagner

1814 Ellis

Wichita, Ks.

67211

Date March 30, 1990.

89-1548

IN THE SUPREME COURT OF THE UNITED STATES

October Term 1989

No. _____

IRVIN D. STAGNER,
Pro Se Petitioner-Appellant

v.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER,JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

Appellees

PETITION FOR WRIT OF CERTIORARI TO

THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

APPENDIX A

Petitioner Pro Se
Irvin D. Stagner
1814 Ellis
Wichita, KS 67211
316 264 2723

IN THE SUPREME COURT OF THE UNITED STATES

October Term 1989

No. _____

IRVIN D. STAGNER,
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v.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER, JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

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PETITION FOR WRIT OF CERTIORARI TO

THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

APPENDIX A

Pursuant S. Ct. Rule 14.2 appendix
as separate document

CONTENTS OF APPENDIX A

JUDGMENTS AND OPINIONS OF THE U. S.

FEDERAL COURTS

CONSTITUTIONAL AND STATUTES INVOLVED

Text Cited

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

89-1724

IRVIN D. STAGNER,
Plaintiff-Appellant,

V.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER,JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

Defendant-Appellees,

DECIDED: January 25, 1990

Before ARCHER, Circuit Judge, COWEN, Senior Circuit Judge. and MAYER, Circuit Judge.

PER CURIAM

DECISION

The June 29, 1989, Memorandum and Order of the United States District Court for the District of Kansas, granting summary judgment against plaintiff-appellant, Irvin D. Stagner, in three consolidated cases, Stagner v. United States Patent and Trademark Office, 11 USPQ2d 1553 (D. Kan. 1989), is affirmed.

OPINION

The present action arises from a lengthy history of patent prosecution in the United States Patent and Trademark Office (PTO) by the appellant, proceeding pro se. Following the PTO proceedings, he filed three civil actions in the United States District Court for the District of Kansas. In an initial decision of May 6, 1988, the district court dismissed the suit for lack of jurisdiction. Stagner v.

United States Patent and Trademark Office. 8 USPQ2d 1173 (D. Kan. 1988). Since Mr. Stagner failed to exhaust his administrative remedies, the district court determined it had no jurisdiction.

However, on reconsideration, the district court determined that it had jurisdiction over Stagner's due process claim based on 28 U.S.C. @@ 1338, covering all actions arising under the patent laws, and 28 U.S.C. @@ 1361 covering actions for mandamus.

In its reconsideration decision, the district court granted summary judgment against Stagner in the three consolidated cases. Stagner v. United States Patent and Trademark Office, 11 USPQ2d 1553 (D. Kan. 1989). The present appeal, which is from that decision, was transferred to this court from the Tenth Circuit.

We agree with the district court's

determination that "the plaintiff has failed to allege any instances in which the patent procedure denied him due process, or any situation in which the Commissioner acted arbitrarily, capriciously, or contrary to law." See Celotex Corp. v. Catrett, 477 U. S. 317 (1986). Mr. Stagner has failed to establish any ground for reversing the court's decision and we find none.

Mr. Stagner argues that the district court, "wrongly construed the complaints filed by the plaintiff-appellant against the defendants-appellees into a merit issue from a clear procedure issue." However, as the district court correctly observed in its decision of May 6, 1988, "the gist of plaintiff's complaint is that he was unlawfully deprived of issuance of a patent and wishes this to review the denial." Moreover, a review of appellant's amended complaint shows that

his basic contention is that the PTO examiner wrongfully and erroneously rejected his application for a patent. Thus, Mr. Stagner's dispute with the examiner's grounds for rejection are disputes on the merits of his applications. Although Mr. Stagner's suits in the district court were premature, the thorough and well-reasoned opinions of that court show that he was accorded all the rights to which he was entitled as a pro se plaintiff.

Finally, we note that our decision in this appeal does not leave Mr. Stagner without a remedy. His fourth patent application is still pending in the PTO. If it is finally rejected by the examiner, he can appeal within the PTO and if dissatisfied with that decision, he can seek judicial review pursuant to either 35 U.S.C. @@ 141 or @@ 145.

UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

89-3175

IRVIN D. STAGNER,
Plaintiff-Appellant,

V.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER,JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

Defendant-Appellees,

ORDER

Before MOORE and EBEL, Circuit Judges.

Appellee's motion to transfer this appeal to the United States Court of Appeals for the Federal Circuit is granted.

FILED SEPT. 5/ 89

UNITED STATES COURT FOR THE DISTRICT OF KANSAS

87-1713-K
87-1714-K
87-1715-K

IRVIN D. STAGNER,

V.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER,JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

JUDGMENT IN A CIVIL CASE

__ Jury Verdict. This action came before the Court for a trial by jury. the issues have been tried and the jury has rendered its verdict.
_X_ Decision by the Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND AJUDGED that the motion for summary judgment filed by the defendants, and each of them, is granted.

FILED JUNE 29, 1989

IN THE UNITED STATES COURT FOR THE
DISTRICT OF KANSAS

87-1713-K FILED
87-1714-K JUN 29/89
87-1715-K

IRVIN D. STAGNER,

Plaintiff,

v.

UNITED STATES PATENT & TRADEMARK OFFICE; COMMISSIONER OF PATENTS, DONALD QUIGG; DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY; PETITION EXAMINER,JEFFREY V. NASE; DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA; SUPERVISOR OF PATENT EXAMINING GROUP 320; FREDERICK R. SCHMIDT; PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN,

Defendants.

MEMORANDUM AND ORDER

In these three consolidated actions, PRO SE plaintiff Irvin D. Stagner seeks money damages for the alleged wrongful denial of his patent applications. Plaintiff brought this action against the United States Patent and Trademark Office, the Commissioner

of Patents, and a number of other individuals in the patent office, who are collectively referred to here as the defendants. This case is currently before the court on defendants' motion to dismiss or in the alternative for summary judgment. Before considering the current motion, however, it is useful to first briefly review the procedural history of these consolidated cases to this point.

In a memorandum and order dated May 9, 1988, this court found that it lacked subject matter jurisdiction and/or venue over plaintiff's complaint. The court reasoned that the "gist" of plaintiff's "prolix" complaint "is that he was unlawfully deprived of the issuance of a patent and wishes this court to review the denial." Stagner v. United States Patent and Trademark Office, et al., Nos. 87-1713, -1714 & -1715, slip op. at 3 (D. Kan. May 9,

1988). The court held that it lacked jurisdiction over the subject matter of plaintiff's complaint because the applicant is first required to present his claims to the Board of Patent Appeals prior to resort to the courts, and the applicant may then obtain judicial review only in the District Court for the District of Columbia. The court concluded:

> In this case, as far as the court can discern from the complaint, the plaintiff has not exhausted his administrative remedies -- i.e., he has not appealed to the Board of Patent Appeals. Thus, the court lacks subject matter jurisdiction. Moreover, even if he had exhausted his administrative remedies, venue would not be proper in this court pursuant to [35 U.S.C.] @145.

Id. at pp. 3-4.

Plaintiff subsequently filed a motion for reconsideration of the court's dismissal, in which he pointed out that after his patent applications were rejected for reasons other than on

the merits, he petitioned the Commissioner of Patent and Trademarks ("Commissioner") as authorized by 37 C.F.R. @1.181(a). The Commissioner subsequently dismissed his petitions and plaintiff contended that the Commissioner's action violated his constitutional right to due process.

The court found that the express statutory avenues of judicial review discussed in its previous order are limited to rejection of claims on the merits by the Board of Patent Appeals, but that decisions of the Commissioner may be reviewed by way of mandamus. Accordingly, the court found it had subject matter over plaintiff's action pursuant to 28 U.S.C. @1338, covering all actions arising under the patent laws, and 28 U.S.C. @1336, covering actions for mandamus. The court concluded:

> Upon review, it appears that plaintiff has at least

> alleged a due process violation and that this court may assert jurisdiction pursuant to 28 U.S.C. @@1338 and 1361. The complaint herein is of such importance to the litigant, and the area of the law is so complex, that plaintiff Stagner is advised by the court to obtain counsel in this matter and to have counsel file amended complaints which comply with Fed.R.Civ.P. 8. At that time, the court may reevaluate the existence of subject matter jurisdiction in this case.

Stagner v. United States Patent and Trademark Office, et al. Nos. 87-1713, -1714 & -1715, slip op. at 2-3 (D. Kan. June 24, 1988).

Despite the court's suggestion, plaintiff has not obtained counsel to assist his in pursuing his action. He did, however, file amended complaints on July 21, 1988.

Defendants have now renewed their motion to dismiss, or in the alternative for summary judgment, on the basis that plaintiff's allegations are directed to the merits of the denial of his patent

application rather than to procedural deficiencies, and thus, the court cannot exercise mandamus jurisdiction. Further, defendants argue that even if the court exercises mandamus jurisdiction, it must find that the Commissioner's actions in responding to the various petitions filed by plaintiff were not arbitrary, capricious, an abuse of discretion, or contrary to law.

Since both parties have presented the court with matters outside the pleading, the court will treat defendants' motion as one for summary judgment pursuant to Fed.R.Civ.P. 12(b).

Summary judgment is proper where the pleadings, despositions, answer to interrogatories, and admission on file, together with affidavits, if any, show there is not genuine issue as to any material fact, and that the moving party is entitled to is entitled to judgement as a matter of law. Fed.R.Civ. P.

56(c). Summary judgment is appropriate in a patent case, as in any other case. Barmaq Barmer Maschinenfbrik AG v. Murate Machinery, Ltd., 731 F.2d 831, 835 (Fed. Cir. 1984). In considering a motion for summary judgment, this court must examine all evidence in a light most favorable to the opposing party. McKenzie v. Mercy Hospital, 854 F.2d 365, 367 (10th Cir. 1988). Further, the party moving for summary judgment must demonstrate its entitlement beyond a reasonable doubt. Ellis v. El Paso Natural Gas Co., 754 F.2d 884, 885 (10th Cir. 1985). The moving party need not disprove plaintiff's claim, but rather, must only establish that the factual allegations have no legal significance. Dayton Hudson Corp. v. Macerich Real Estate Co. 812 F.2d 1319, 1323 (10th Cir. 1987).

In resisting a motion for summary judgment, the opposing party may not

rely upon mere allegations, or denials, contained in its pleadings or briefs. Rather, the moving party must come forward with specific facts showing the presence of a genuine issue of material fact for trial and significant probative evidence supporting the allegations. Burnette v. Dresser Industries, Inc., 849 F.2d 1277, 1284 (10th Cir. 1988). One of the principal purposes of summary judgment is to isolate and dispose of factually unsupported claims or defenses, and the rule should be interpreted in a way that allows it to accomplish this purpose. Celotex Corp. v. Catrett, 477 U.S. 317 (1988).

Defendants have provide the court with copies of the relevant portions of the administrative record of the Patent and Trademark Office. The pages of the administrative record have been renumbered with "Bates" page numbers. In this order, the court will simply

refer to the administrative record as "Record", followed by the appropriate page number.

Findings of Fact

Plaintiff filed his first patent application On August 1, 1983. The application was examined and an office action issued June 12, 1984 by examiner James Smith. Plaintiff's claims were rejected as failing to define the invention in a manner specified by 35 U.S.C. @112. On July 11, 1984, plaintiff filed on amendment to the applications which changed that text of the claims. The patent examiner repeated the rejection under @112 in a final rejection entered September 6, 1984.

A second patent application containing one claim was filed by Stagner on November 13, 1984. On September 13, 1985, this claim was rejected under 35 U.S.C. @112 and 35

U.S.C. @103 (obviousness). (1) On October 15, 1985, Stagner filed a 35-page amendment to his claim, 13 pages of which consist of references to case digests in Title 35 of U.S.C.A. On December 18, 1985, the rejection under @103 was made final. The office action cited three patent references (prior art), and pointed to features in the prior art that render the invention unpatentable.

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(1) 35 U.S.C. @103 provides in relevant part:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

On January 2, 1986, Stagner filed a petition to the Commissioner under 37 C.F.R. @1.181, asking for "reexamination and reconsideration" of his application by a different examiner. The petition basically alleged that the examiner failed to make a complete study of Stagner's patent application or a thorough investigation of the available prior art relating to the application. Further, Stagner contended the patent application examiner erred in maintaining a rejection under 35 U.S.C. @103. On that same date, Stagner failed a document which was considered a request for reconsideration of the final rejection. In decision dated February 5, 1986. the examiner indicated that this document did not overcome the final rejection.

The January 2, 1986 petition was answered in a decision dated February 13, 1986. The decision initially points

out that Stagner failed to explain the basis for his contention that the examiner did not conduct a complete investigation. Further, the decision states that a "review of the record indicates that the Examiner has [conducted a complete examination] and thus it is not agreed that he has failed to comply with [37 C.F.R. @1.104(a)]." (Record, p. 0257.) Finally, the decision points out that Stagner's contention that the examiner erred in rejecting his claims on the prior art references is directed entirely to the merits of the examiner's rejection of the claim and "the statutes provide an Appeal procedure to the combined Board of Appeals and Interferences to resolve this differences." Id.

— On March 3, 1986, Stagner filed a document addressed to the Commissioner which was treated as a request for reconsideration of the February 13, 1986

decision. On March 10, 1986, Stagner filed a third patent application and "brief" with exhibits.

On May 15, 1986, the Patent Examining Group Director responded to Stagner's March 3 and March 10 communications. Plaintiff's March 3, 1986 request for reconsideration was granted to the extent that it was itself considered on the merits. Reconsideration of the application itself was denied. Stagner subsequently returned this response to the group director with the notation "Action Voided--Not Acceptable--Voided" written in bold print across the letter. (Record, p. 0396.)

As for plaintiff's March 10, 1086 communications, the group director noted that the "brief" filed by plaintiff "consists of a listing of legal interpretations of the patent statutes and general allegations regarding the

patentability of the combined 90 degree and 45 degree angled socket extension set. This paper has been made a record in the application file but is not responsive to the December 18, 1985 final rejection." (Record, p. 0394.)

In an action issued December 22, 1986, plaintiff's third patent claim was rejected by the examiner under 35 U.S.C. @112 for failing to provide an adequate written description of the invention, and under @103 for obviousness.

On February 19, 1987 Stagner filed four additional documents: a 78-page amendment to be entered in the third application; (2) a copy of a letter previously filed on June 2, 1986; (3) a "petition" to the Commissioner alleging "ex parte" (biased) examination plaintiff's application and failure to follow the rules for examination of applications; and (4) a petition to the Commissioner containing a complaint

against the group director alleging the group director alleging discourteous conduct.

On March 17, 1987, plaintiff filed a "Amendment of An Amendment." The patent office did not enter this document as part of the record because it was unconventional and did not present any amendment to the specification or claim.

Deputy Assistant Commissioner for Patents, James Denny, responded on August 21, 1987, to Stagner's February 19, 1987 petition and complaint to discourteous conduct. Denny advised Stagner that "a careful review" of all the records concerning Stagner's patent applications revealed nothing which would indicate that the examiner acted in any manner inconsistent with the statutes and rules governing the prosecution of application for patents. (Record, p. 06164.) Denny further

explained the distinction between appealable and petitionable matters and advised Stagner to obtain a patent practitioner to advise him in the prosecution ok his patent application.

On September 1, 1987, Stagner sent letters to the Commissioner and Deputy Assistant Commissioner complaining of improper examining practices. Examiner Jeff Ness review Stagner's files and concluded that proper examining procedures had been followed. Stagner was again advised that disagreements over the relevance of prior art references must be appealed to the board.

On October 5, 1987, plaintiff filed a letter advising that the third patent application had been abandoned and a fourth application was being filed, and a document entitled "Rebuttal and Remarks." Plaintiff also filed a petition to the Commissioner.

On June 1, 1988 plaintiff's fourth

application was rejected under 35 U.S.C @@112 and 103. Stagner's petition and "Rebuttal and Remarks" were not consider since these papers addressed issues in an abandoned application.

Finally, on July 22, 1988, a letter was issued advising Stagner of a co-pendency problem between his third and fourth applications. This letter apparently was in error and a corrective letter was issued on August 2, 1988.

Conclusions of Law

Prior to considering defendants' argument for summary judgment, the court initially notes that while this decision has been somewhat delayed, at least part of that delay is due to the court's difficulty in interpreting plaintiff's claims and contentions in this technical area of the law. Plaintiff has chosen to ignore the court's admonitions to obtain experienced counsel to assist him, and consequently the court has had

to analyze and consider plaintiff's claims as best it could.

In support of their motion for summary judgement, defendants assert that plaintiff's amended complaints, as well as his deposition testimony and brief filed in response to defendants' summary judgment motion, fail to specify any due process violation in the conduct of the examination of plaintiff's patent application or any breach of duty by the Commissioner with respect to plaintiff's various petitions.

Plaintiff responds to defendants' arguments by making numerous promises to "prove at a trial" that defendants deprived him of due process in the processing of his patent applications. Plaintiff may not, however, resist a motion for summary judgement by relying on mere allegations or denials contained in pleading or briefs, but rather, must come forward with specific facts showing

a genuine issue of material fact for trial. Fed.R.Civ.P. 56(e).

Although this briefs and amended petition are convoluted and difficult to follow, the court discerns that plaintiff's primary complaint is that the examiners did not address each and every issue raised in his petitions, nor did they respond to every case cited in his "briefs" and "rebuttals". As is apparent from the detailed procedural history recited in the fact-finding portion of this memorandum, each document filed by the petitioner was considered and acted upon by the Commissioner.

Moreover, questions concerning the sufficiency and correctness of the examiner's determinations go to the merits of plaintiff's allegations and are thus not within this court's jurisdiction. Where plaintiff disputes a denial of patent claims based on prior

art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits. In re James, 432 F.2d 473, 475 (CCPA 1970); In re Weichert, 370 F.2d 927, 938 (CCPA 1967). As this court has previously noted, appeals on the merits must be made to the Board of Patent Appeals prior to resort to the court. See generally 3 CHISUM, Patents @11.06 (1988).

That plaintiff's complaints go to the merits of the denial of his applications is further supported by his request that the court "Grant Letters of Patent in accordance with Title 35 USCA and 37 CFR as proven by the Plaintiff." (Plaintiff's Response, p. 5.) Until plaintiff obtains a review of the merits of the rejections by the Board of Patent Appeals, there can be no review of the Patent Office's determination as to

whether plaintiff is entitled to a patent. If plaintiff were to prevail in this mandamus action, his remedy would not include the grant of a patent.

Further, as defendants point out, plaintiff has not shown any of the Commissioner's decision to be arbitrary, capricious, and abuse of discretion, or otherwise contrary to the law. Rather, the uncontroverted evidence indicates that the Commissioner considered and responded to each of plaintiff's petitions of "communications". For instance, on February 13, 1986, the Commissioner responded Stagner's January 2, 1986 petition seeking reexamination and reconsideration of his application. The Commissioner stated in his response that he had reviewed the record and determined that the examiner had conducted a complete examination as to merit and form and that petitioner's other arguments related to the merits of

the examiner's rejection of the claim and that such questions are appealable to the board.

Moreover, on August 2, 1987, the Commissioner responded to Stagner's February 19, 1987 petition and to his complaints of discourteous conduct. In the response the Commissioner stated that a review of the record indicated no improper examiner procedures or conduct. The Commissioner went on to explain to plaintiff the difference between appealable and petitionable matters and advised him to obtain the services of a patent practitioner.

These responses are representative of the numerous responses made by the Commissioner to Stagner's petitions and communications, as more fully detailed in the court's finding of facts. Not only does it not appear to the court that the Commissioner's actions were arbitrary or capricious, it is clear

that the Commissioner went beyond his duty on several occasions in an attempt to assist the plaintiff with some to the conceptual and procedural difficulties he seemed to have with the patent process.

Under these circumstances, the court has not hesitation in finding that the plaintiff has failed to allege any instance in which the patent procedure denied him due process, or any situations in which the Commissioner acted arbitrarily. capriciously, or contrary to the law.

IT IS ACCORDINGLY ORDERED this 28 day of June, 1989, that defendants motion for summary judgment is granted.

IN THE UNITED STATES COURT FOR THE
DISTRICT OF KANSAS

87-1714-K

IRVIN D. STAGNER,

Plaintiff,

V.

UNITED STATES PATENT & TRADEMARK OFFICE, et al.,

Defendants.

ORDER GRANTING MOTION TO RECONSIDER

On June 24, 1988, the court entered a Memorandum Order in Stagner v. United States Patent and Trademark Office, et al., Civil Action No. 87-1713-K, granting plaintiff's motion to reconsider the court's Memorandum and Order of May 9, 1988. Consistent with the June 24 order, plaintiff's motion to reconsider the May 9, 1988 order in this companion case is granted.

IT IS SO ORDERED this 28 day of June, 1988.

IN THE UNITED STATES COURT FOR THE
DISTRICT OF KANSAS

87-1713-K FILED JUN 24/88

IRVIN D. STAGNER,

Plaintiff,

V.

UNITED STATES PATENT & TRADEMARK OFFICE, et al.,

Defendants.

MEMORANDUM ORDER

This matter is before the court on plaintiff Irvin D. Stagner's motion for the court to reconsider its memorandum and order of May 9, 1988, in which it dismissed plaintiff's complaints due to lack of subject matter jurisdiction and improper venue. The court based its decision on 35 U.S.C. @@ 135, 141 and 145, which provide that an applicant whose patent is denied may appeal to the Board of Patent Appeals, and if dissatisfied with that decision, may

appeal only to the Federal District Court for the District of Columbia or the Court of Appeals for the Federal Circuit. It appeared to the court that plaintiff had failed to exhaust his administrative remedies, although the procedural history was difficult to discern from plaintiff's prolix, pro se complaints.

The plaintiff has now filed his motion to reconsider. Up careful review of the same, the court is now convinced that it may exercise subject matter jurisdiction over this case.

The court now garners that following the examiner's
rejection of plaintiff's patent application for reasons other than on its merits, the plaintiff petitioned the Commissioner of Patents and Trademarks as authorized by 37 C.F.R. @1.181(a). The commissioner subsequently dismissed the petition. Plaintiff now alleges

that the commissioner's action violated his constitutional right to due process, and he seeks review in this court.

The express statutory avenues of judicial review discussed by this court in its order of May 9, 1988, are limited to rejection of claims on the merits by the Board of Patent Appeals. However, decisions of the commissioner may be reviewed by way of mandamus. All federal district Courts have subject matter jurisdiction over such review actions pursuant to 28 U.S. C. @1338, covering all actions arising under the patent laws, and 28 U.S.C. @1361, covering actions for mandamus. Service of process and venue are authorized in the district of plaintiff's residence. 28 U.S.C. @@1361, 1391(e).

Mandamus will lie to provide jurisdiction to a federal court in order to define and compel compliance with due process requirements or to compel the

official to comply with the law when the claim is clear and certain that the duty of the officer is purely ministerial. Lee Pharmaceuticals v. Creps., 577 F. 2d 610 (9th Cir. 1978). Of course, the patent applicant must have exhausted his administrative remedies before mandamus will lie. See United States ex rel Steinmetz v. Allen, 192 U.S. 543 (1904).

Upon review, it appears that plaintiff has at least alleged a due process violation and that this court may assert jurisdiction pursuant to 28 U.S.C @@ 1338 and 1361. The complaint herein is of such importance to the litigant, and the area of the law is so complex, that plaintiff Stagner is advised by the court to obtain counsel in this matter and to have counsel file amended complaints which comply with Fed.R.Civ.P. 8. At that time, the court may reevaluate the existence of subject matter jurisdiction in this case.

IT IS ACCORDINGLY ORDERED this 24 day of June, 1988, that plaintiff's motion to reconsider the court's order of May 9, 1988 is granted. Plaintiff is further advised to obtain counsel in this matter or to show cause as to why the should not. The parties are further ordered to appear for status conference in chambers on August 15, 1988, at 1:00 P.M.

UNITED STATES COURT FOR THE DISTRICT OF KANSAS

87-1715-K FILED MAY 10/88

IRVIN D. STAGNER,

V.

UNITED STATES PATENT & TRADEMARK OFFICE, et al

JUDGMENT IN A CIVIL CASE

__ Jury Verdict. This action came before the Court for a trial by jury. the issues have been tried and the jury has rendered its verdict.

_XX_ Decision by the Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND AJUDGED pursuant to Memorandum and Order filed May 9, 1988, defendants' motion to dismiss is granted.

ORDERED that plaintiff, Irvin D. Stagner, shall take nothing, the action is dismissed, and the defendants, United States Patent and Trademark Office, et al, shall recover of plaintiff their costs of action.

IN THE UNITED STATES COURT FOR THE DISTRICT OF KANSAS

87-1714-K

IRVIN D. STAGNER,

Plaintiff,

V.

UNITED STATES PATENT & TRADEMARK OFFICE,
et al

Defendants.

ORDER OF DISMISSAL

On May 9, 1988, the court entered a Memorandum and Order granting defendants' motion to dismiss the complaint of the Plaintiff in the Stagner v. United States Patent and Trademark Office, et al., Civil Action No. 87-1715-K. Consistent with the conclusions of law and findings of fact set forth therein, the court finds that this companion case should be dismissed.

IT IS SO ORDERED this 9 day of May, 1988.

UNITED STATES COURT FOR THE DISTRICT
OF KANSAS

87-1713-K
87-1714-K
87-1715-K

IRVIN D. STAGNER,

V.

UNITED STATES PATENT & TRADEMARK OFFICE, et al

TAKE NOTICE that the above-entitled case has been set for hearing (see above) at 3:00 P.M. , on April 4 1988, at the United States Courthouse, Wichita, Kansas, Room 232, before the Honorable Patrick F. Kelly, Judge.

Dated February 26, 1988.

To Mr. Irvin D. Stagner

Mr. Stephen K. Lester

Plaintiff's response due on or before 3-21-88

Defendants' reply due on or before 3-28-88

APPENDIX VERBATIM

TITLE 35 U.S.C.A.

INVENTIONS PATENTABLE

35 U.S.C.A. 101

Whoever invents or discovers any new and useful process, machine, manufactures, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT

35 U.S.C.A. 102

A person shall be entitled to a patent unless--

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representative or assigns in a foreign country prior to the date of the application for patent in this country on a application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United

States before the invention thereof by the applicant for Patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of this section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, Suppressed, or concealed it. in determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from time prior to conception by the other.

CONDITIONS FOR PATENTABILITY;

NON-OBVIOUS SUBJECT MATTER

35 U.S.C.A. 103

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

APPEAL TO COURT OF APPEALS FOR THE FEDERAL CIRCUIT

35 U.S.C.A. 141

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Appeals for the Federal Circuit, THEREBY WAVING HIS RIGHT TO PROCEED UNDER SECTION 145 OF THIS TITLE.

CIVIL ACTION TO OBTAIN PATENT

35 U.S.C.A. 145

An applicant dissatisfied with the decision of the Board of Appeals may UNLESS APPEAL HAS BEEN TAKEN TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, have remedy by civil action against the commissioner in the United States District Court for the district of Columbia if commenced within such decision.....

BENEFIT OF EARLIER FILING DATE

IN THE UNITED STATES

35 USC 120

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is file by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting of abandonment of or termination of proceedings on the first application or on an application similarly entitle to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

FIRST TITLE 35 U.S.C.A AND 37 C.F.R.

NATURE OF EXAMINATION; EXAMINERS ACTION
37 CFR 1.104

(a) On taking up an application for examination or a patent in reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matter of form, unless otherwise indicated.

(b) The applicant, or in the case of reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The

reasons for any adverse action or any objection or requirement will be stated and such information or reference's will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

COMPLETENESS OF EXAMINER'S ACTION

37 CFR 1.105

The examiner's action well be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defect in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matter of form need not be raised by the examiner until a claim is found allowable.

REJECTION OF CLAIMS

37 CFR 1.106

(a) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those consider unpatentable will be rejected.

(b) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(c) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a

reexamination preceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon fact within his or her knowledge pursuant to

CITATION OF REFERENCES

37 CFR 1.107

(b) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject contradiction or explanation by affidavits of the applicant and other persons.

CONTINUATION OR DIVISIONAL APPLICATION FOR INVENTION DISCLOSED IN PRIOR APPLICATION

37 CFR 1.60

(a) A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 [35 U.S.C.A. 120 or 121] and 1.78 (a), which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceeding on the prior application.

(d) If an application which has been accorded a filing date pursuant to paragraph (a) of this section does not include the appropriate basic filing fee pursuant to paragraph (b) of this section, or an oath or declaration by the applicant in the case of a

continuation-in-part application pursuant to paragraph (c) of this section, applicant can be so notified and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application. The notification pursuant to this paragraph may be made simultaneously with any notification of a defect pursuant to paragraph (a) of this section.

REPLY BY APPLICANT OR PATENT OWNER

37 CFR 1.111

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persist in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration of further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentability

distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections (See 1.135 and 1.136 for time for reply).

RECONSIDERATION

37 CFR 1.112

After response by applicant or patent owner (1.111), the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirement made, in the same manner as after the first examination. Applicant or patent owner may respond to such Office action in the same manner provided in 1.111, with or without amendment. Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under reexamination will be again considered, and so repeatedly, unless the examiner has indicated that the action is final.

FINAL REJECTION OR ACTION

37 CFR 1.113

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (1.191), or to amendment as specified in 1.116.

Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (1.181).

Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim.

If any claim stands allowed, the response to a final rejection or action must comply with and requirements or objection as to form.

(b) In making such final rejection, the

examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.is final.

FINAL REJECTION OR ACTION

37 CFR 1.115

The applicant may amend before or after first examination and action and also after the second action or subsequent examination or reconsideration as specified in 37 CFR 1.112 or when and as specifically required by the examiner. The patent owner may amend in accordance with 37 CFR 1.510(e) and 1.510(b) prior to reexamination, and during reexamination in accordance with 37 CFR 1.112 and 37 CFR 1.116.

AMENDMENTS AFTER FINAL ACTION

37 CFR 1.116

(a) After final rejection or action (37 CFR 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of or refusal to admit any amendment after final rejection and any proceedings relative thereto shall not operate, to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under 37 CFR 1.135.

(b) If amendments touching the merits of the application or patent under

reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon sufficient reason why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in 37 CFR 1.198, or to carry into a recommendation under 37 CFR 1.196.

PETITION TO THE COMMISSIONER

37 CFR 1.181

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Appeals or to the court;

(2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must

accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution for an application, it may be required that there have been a proper request for reconsideration (1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the

Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

APPEAL TO THE BOARD OF APPEALS AND INTERFERENCES

37 CFR 1.191

(A) Every applicant for a patent or a reissue of a patent, or every owner of a patent under reexamination, any claims of which have been twice rejected or who has given a final rejection (1.113), may, upon the payment of the fee set

forth in 1.17(e) appeal from the decision of the examiner to the Board of Patent Appeals and Interferences within the time allowed for response.

28 USC 1654

APPEARANCE PERSONALLY OR BY COUNSEL

"In all courts of the United States the parties may plead and conduct their own cases personally or by counsel as, by the rules of such courts, respectively are permitted to manage and conduct causes therein. June 25, 1918, c. 616, 62 Stat. 944; May 24, 1949, c. 139, USC 91, 63 Stat. 103.

actions on the record made before the administrative agency;

4. Forfeiture proceedings.

At the conclusion of the pretrial proceedings. the pretrial order shall be filed with the clerk. Issue shall then be deemed joined, and the case will be ready for trial.

The pretrial order in in all civil non-jury cases shall require each of the parties to file with the clerk, within a time certain:

a. A summary of the anticipated testimony of the witnesses, and other evidence the party plans to offer;

b. A trial brief or memorandum of law; and,

c. Proposed findings of fact and conclusions of law.

In cases based on 42 U.S.C. Section 2000e-2, 2000e-3, and 2000e-5, within

120 days after the pretrial order is filed, the judge shall either cause the case to be tried or appoint a master, pursuant to Rule 53, Federal Rules of Civil Procedure, to take the evidence.

60 Am Jur 2d

@495. Final rejection or action

The examiner may make final the rejection or other action on a claim after the second or any subsequent examination or reconsideration.(45) The claims may be finally rejected in the first Patent and Trademark Office action only in the case of a continuing or substitute application. (46) Any question as to the prematureness of a final rejection should be raised while the case is still pending before the primary examiner, and the question is reviewable by petition to the Commissioner of Patents and

Trademarks.(47) In making such final rejection, the examiner must repeat or state all the grounds of rejection

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(45) 37 CFR @@ 1.112.

(46) MPEP (5th ed) @@706.07(b).

(47) MPEP (5th ed) @@706.07(c).

then considered applicable the claims in the case and clearly state the reasons therefor.(48)

The applicant's response to a final rejection or action must include cancellation of or appeal from the rejection of each rejected claim, and for any claim which stands allowed, the applicant must comply with any requirement or objection as to form. (49)

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(48) 37 CFR @@ 1.113(b).

(49) 37 CFR @@ 1.113(a).

XV. PETITION TO THE COMMISSIONER [@@ 566-575]

A. In General [@@ 556-571]

Research References

37 CFR @@ 1.181-1.184

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Patents @@ 52:31 et seq.

@@566. Generally; matters petitionable and not appealable

A petition may be taken to the Commissioner of Patents and Trademarks from any action or requirement of a patent examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or the U.S. Court of Appeals for the Federal Circuit.(20) Traditionally, in such

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(20) 38 CFR @@1.181(a)(1).

cases, an examiner's ruling dealing with procedural matters are reviewable upon petition to the Commissioner, while substantive questions dealing with patentability are reviewable by the Board and the court,(21) and where a petitioner has the right to appeal or file a civil action, review by the Commissioner is not appropriate.(22)

Petitions may also be taken to the Commissioner when a statute or rule specifies that the matter is to be determined directly by the

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(21) Application of Searles, 57 CCPA 912, 422 F2d 431, 164 USPQ 623; Application of Newton 56 CCPA 1463, 414 F2d 1400, 163 USPQ 34.

(22) Giraldi v. Carney (Comr Pats) 207 USPQ 230.

For a discussion of those matter which

are appealable to the Board of Patent Appeals and Interferences, see @@743 et seq.

Commissioner, (23) or, when appropriate, to invoke the Commissioner's supervisory authority. (24)

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(23) 37 CFR @@1.181(a)(2).

Practice Aids.--Petition to Commissioner--for retroactive licenses for foreign filing. 13 FEDERAL PROCEDURAL FORMS. L ED. PATENTS @@52:32.
Petition to Commissioner--To make special 13 FEDERAL PROCEDURAL FORMS L Ed. PATENTS @@52:33.

Petition to Commissioner--To reverse decision denying applicant retroactive license--Application inadvertently filed abroad and does not disclose invention subject to secrecy. 13 FEDERAL PROCEDURAL FORMS. L Ed. PATENTS @@52.34.

(24) 37 CFR @@ 1.181(a)(3).

Practice Aids.--Petition to Commissioner--To exercise supervisory authority and direct examiner to provide report of examination of

claims as to chemical compound--Rejection of claims has been asserted by their withdrawal from further consideration. 13 FEDERAL PROCEDURAL FORMS. L Ed PATENTS @@ 52:31.

petition to Commissioner--To vacate examiner's requirement to cancel certain words from specifications. 13 FEDERAL PROCEDURAL FORMS,L Ed. PATENTS @@52.35

@@567. Necessity of request for reconsideration

When the petition is taken from an action of an examiner in the ex parte prosecution of an application, a proper request for reconsideration (25) and repeated action by the examiner may be required before review is granted.(26) A petition for review of an examiner's requirement that the applicant elect the invention to which his claim shall be restricted will not be considered if reconsideration of the requirement was not requested.(27)

@@ 568. Petition; content and response

The petition must contain a statement of the facts involved, the points to be reviewed, and the action

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(25) As to request for reconsideration, see @@ 193

(26) 37 CFR @@ 1.161(c).

(27) 37 CFR @@ 1.144.

requested.(28) Any briefs or memoranda in support of the petition must accompany or be embodied in the petition and, where fact are to be proven, proof in the form of affidavits, declarations, or exhibits must accompany the petition.(29)

While the regulations do not provide for the filing of documents in opposition to the petition, the Commissioner of Patents and Trademarks will consider a respondent's response in appropriate cases.(30)

***Caution: The appropriate section of the Rules of

Practice in Patent Cases will

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(28) 37 CFR @@ 1.181(b)

(29) 37 CFR @@ 1.181(b).

(30) Guzman v. Schept (Comr Pats) 207 USPQ 220, petition den (Comr Pats) 207 USPQ 222.

indicate whether a fee is required for a petition to the Commissioner.(31) Any petition on a question not specifically provided for in the Rules must be accompanied by a set fee.(32) A petition which is not accompanied by the required fee will be dismissed. (33)

@@ 569. --Time for filing

Except as otherwise provided in the Rules of Practice in Patent Cases, a petition must be filed within 2 months

of the action complained of, or it may

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(31) 37 CRF @@ 1.181(d).

For a list of the required fees for petitions, see 37 CFR @@ 1.17(h)-(m).

(32) 37 CFR @@ 1.182.

(33) 37 CFR @@ 1.181(d).

be dismissed as untimely. (34) Filing a petition will not stay the period for reply to an examiner's action which may be running against an application or act as a stay of any other proceeding.(35)

@@570. Hearing and determination

Oral hearing will not be granted except when considered necessary by the Commissioner of Patents and Trademarks,(36) and it is not the Commissioner's practice to grat such hearings.(37) Cases not specifically provided for in the Rules of Practice in

Patent Cases are decided in accordance with their merits communicated to the interested parties in writing.(38)

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(34) 37 CFR @@ 1.181(f).

(35) 37 CFR @@ 1.181(f).

(36) 37 CFR @@ 1.181(c).

(37) Chauvette v. Scartazzini (Cmmr Pats) 206 USPQ 764.

Cases which have been decided by one Commissioner will not be reconsidered by a successor Commissioner except in accordance with the principles governing the granting of a new trials.(39)

@@ 571. Suspension or waiver of rules

An interested party may petition the Commissioner of Patents and Trademarks, in a extraordinary situation and when justice requires, for a waiver of suspension of any requirement of the Rules of Practice in Patent Cases which

is not a requirement of the statutes.(40) To justify such a

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(38) 37 CFR 1.182.

(39) 37 CFR @@ 1.184.

(40) 37 CFR @@ 1.183.

suspension of the rules, the petitioner must demonstrate the existence of an extraordinary situation in which justice requires the suspension,(41) and it is not sufficient merely to show that no special damage would result from any suspensions. (42) Of course, a suspension which would be contrary to statutory requirements in improper, (43) but it has been held that a rule requiring civil actions to be commenced within 60 days of Patent and Trademark Office decisions, which was adopted pursuant to the Commissioner's statutory

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(41) Nichols v. Sayman (Comr Pats) 210 USPQ 301: Dingwall v. Morozumi (Comr Pats) 207 USPQ 1137.

(42) Myers v. Feigelman, 59 CCPA 834, 455 F2d 596, 172 USPQ 580, later app (CCPA) 476 F2d 1375, 177 USPQ 530

(43) Re AMP. Inc. (commr Pats) 212 USPQ 826.

authority to "appoint" the time within which such actions must be taken, to be not less than 60 days,(44) is not a requirement of the statutes and can be waived.(45) When the Commissioner determines that a suspension is proper, he may, in his discretion, select the particular remedy he deems most appropriate. (46)

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(44) For a discussion of the time for filing a civil action to obtain a patent, see @@783.

(45) Eckey v. Watson, 106 App DC 16, 268 F2d 891, 122 USPQ 5.

(46) Mobil Oil Cor. v. Dann (DC Dist Col) 421 JF.Supp 995. 197 USPQ 59, later app (DC Dist Col) 448 F.Supp 487, 198 USPQ 347.

B. Judicial Review of Commissioner's Decisions [@@ 572-575]

Research References
35 USCS @@141
ALR Digest to 3d, 4th, and Federal, Patents @@ 12
Index to Annotations, Patents
19 Am Jur Pl & Pr Forms (Rev), Patents, Form 7

@@ 572. Jurisdiction of District Court

The Court of Appeals for the Federal Circuit (formerly the Court of Customs and Patent Appeals) is given jurisdiction only over appeals from the Board of Patent Appeals and Interferences.(47) Therefore, review of the decisions of the Commissioner of Patents and Trademarks on petitions is available only in District Court.(48)

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(47) 35 USCS @141

(48) Re Makari (CA FC) 708 F2d 709, 218 USPQ 247.

@@ 573. Review by way of mandamus

Decisions of the Commissioner of Patents and Trademarks on petitions are reviewable in District Court by mandamus.(49) However, such relief is limited to situations where the Commissioner's decision on the petition violates a duty owed to the plaintiff and is not available where the Commissioner's decision is discretionary in nature.(50)

The Court of Appeals for the Federal Circuit may issue a writ of mandamus to review a decision of the Commissioner only if they decision would otherwise frustrate the Court's prospective jurisdiction on appeal from an eventual decision of the Board of Appeals or Board of Patent Interferences.(51)

(49) Application of Mindick, 54 Cust & Pat App 1053, 371 F2d 892; Application of Wiechert, 54 CCPA 957, 370 F2d 927, 142 USPQ 247.

petition for writ of mandamus directing trial court to vacate order directing patent owner to petition Patent And Trademark Office (PTO) to revive abandoned reissue application for expired patent is denied as premature where PTO has not yet been petitioned and formally denied or granted petition. Baker Perkins, Inc. v. Werner & Pfleiderer Corp. (CA FC) 710 F2d 1561, 218 USPQ 577.

(50) Godtfredsen v. Banner (DC Dist Col) 297 USPQ 202.

Practice Aids--Complaint--In District Court--In nature of mandamus--To compel Commissioner of Patents and Trademarks to issue retroactive license for foreign filing. 19 Am Jur Pt. & PR FORMS (Rev), PATENTS, Form 7.

(51) RE Makari (CA FC) 708 F2d 709, 218 USPQ 193.

@@ 574. Review under Administrative Procedure Act

Review of the decision of the Commissioner of Patents and Trademarks which constitute final agency action such as the denial of a retroactive license for a foreign patent, (52) is available under the Administrative Procedure Act. (53) However, the only review provided for under the APA is review of final agency actions and not the review of a procedural order. (54) and review of the Commissioner's interlocutory decisions in not available.(56)

(52) Reese v. Dann (DC Dist Col) 391 F Supp 12, 185 USPQ 492.

(53) 5 USJCS @@701 et seq.

(54) Eastman Kodak Co. v. Mossing hof CA4 Va) 704 F2d 13129, 217 USPQ 1190 (review of examiner's decision denying a protest); Phillips Petroleum CO. v. Brenner, 127 App DC 319, 383 F2d 514, 154 USP 211, cert den 389 US 1042, 19 L Ed

2d 833, 88 S Ct 785, 156 USPQ 720

(55) Klein v. Commissioner of Patents (CA4 Va) 474 F2d 821, 177 USPQ 1; Godtfedsen v. Banner (DC Dist Col) 297 USPQ 202.

(56) @@ 573.

@@ 575. What determinations are reviewable

Mandamus will lie(56) or an action under the Administrative Procedure Act may be maintained,(57) to compel the Commissioner of Patents and Trademarks to permit amendment of a claim(58) or revival of an abandoned application;(59) to compel him to require an examiner to forward an appeal to the Board of Patent Appeals and Interferences; (60) or to compel him to sign a patent.(61)

The District court cannot consider striking patents for fraud at the behest of the interference loser when the issue was not raised or decided at the Patent and Trademark Office.(62)

(57) @@ 574.

(58) Sikora v. Brenner, 126 App. DC 375, 379 F2d 134, 153 USPQ 585; Re Mindick, 54 CCPA 1053, 371 F2d 892, 152 USPQ 566.

(59) Commissariat A. L'Enerie Atomique v. Watson, 107 App DC 85, 274 F2d 594, 124 USPQ 566.

(60) United States ex rel. Steinmets v. Allen, 192 US 543, 48 L Ed. 555, 24 S Ct 416

(61) Butterworth v. United States, 112 US 50, 28 L Ed 656, 5 S Ct 25.

(62) Wm. T. Burnett & Co. v. General Tire & Rubber Co. (DC Md) 545 f. Supp 794, 200 USPQ 223, affd without op (CA4 Md) 609 F2d 512 cert den 446 US 951, 64 L Ed 2d 807, 100 S Ct 2916 rch den 448 US 912, 675 l Ed 2D 1173, 101 S Cts 7 and affd (CA4) 203 USPQ 801

89-1548

IN THE SUPREME COURT OF THE UNITED STATES

October Term 1989

No. _____

IRVIN D. STAGNER,
Pro Se Petitioner-Appellant

v.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER, JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

Appellees

PETITION FOR WRIT OF CERTIORARI TO

THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

APPENDIX B

Petitioner Pro Se
Irvin D. Stagner
1814 Ellis
Wichita, KS 67211
316 264 2723

IN THE SUPREME COURT OF THE UNITED STATES

October Term 1989

No. _____

IRVIN D. STAGNER,
Pro Se Petitioner-Appellant

v.

UNITED STATES PATENT & TRADEMARK OFFICE, COMMISSIONER OF PATENTS, DONALD QUIGG, DEPUTY ASSISTANT COMMISSIONER, JAMES E. DENNY, PETITION EXAMINER,JEFFREY V. NASE, DIRECTOR OF PATENT EXAMINING GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR OF PATENT EXAMINING GROUP 320, FREDERICK R. SCHMIDT, PATENT EXAMINERS OF GROUP 320, JAMES G. SMITH AND DEBRA MEISLIN

Appellees

PETITION FOR WRIT OF CERTIORARI TO

THE UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

APPENDIX B

Pursuant S. Ct. Rule 14.2 appendix as a separate document and S. Ct. Rule 33 (d), patent case, appendix as a different size document .

CONTENTS OF APPENDIX B

DECISIONS OF THE PATENT
AND TRADEMARK OFFICE

OFFICE ACTIONS (REJECTIONS).
See Administrative Record
Application Serial No. 671,168.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	

[illegible]

EXAMINER	
ART UNIT	PAPER NUMBER
	3

DATE MAILED

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ day(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claim(s) 1 are pending in the application.

   Of the above, claim(s) _____ are withdrawn from consideration.

2. ☐ Claim(s) _____ have been cancelled.
3. ☐ Claim(s) _____ are allowed.
4. ☑ Claim(s) 1 are rejected.
5. ☐ Claim(s) _____ are objected to.
6. ☐ Claim(s) _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable, ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____, filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. ☐ Other

PTOL-326 (Rev. 7-80)

EXAMINER'S ACTION

0085

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim appears to recite each extension having two square openings and male square heads.

2. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Ayotte or Lareau and Ossul. It would be obvious to use both 45° bend extensions, as shown by Ayotte or Lareau, and 90° bend extensions, as shown by Ossul, in a set.

4. Any inquiry concerning this communication should be directed to Examiner James G. Smith at telephone number 703-557-6502.

9/10/85:slw.

James G. Smith
JAMES G. SMITH
EXAMINER
Art Unit 323

FORM PTO-892 (REV. 3-78)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED

SERIAL NO	GROUP ART UNIT	ATTACHMENT PAPER NUMBER
671168	323	3

APPLICANT(S): STAGER

U.S. PATENT DOCUMENTS

*		DOCUMENT NO	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
✓	A	1,419,100	6/1922	AYOTTE	87	177.2	
	B						
	C						
	D						
	E						
	F						
	G						
	H						
	I						
	J						
	K						

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO	DATE	COUNTRY	NAME	CLASS	SUB CLASS	PERTINENT SECTS.	PP. DRWG.
✓	L	840339	1/1939	FRANCE	GUIZENE	87	177.2	—	
✓	M	8003	12/1907	FRANCE	CISSÉE	87	177.2	—	
	N								
	O								
	P								
	Q								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

R	
S	
T	
U	

EXAMINER	DATE
James G. Smith	9/4/85

* A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, Section 707.05(a).)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO

EXAMINER

ART UNIT	PAPER NUMBER
	7

DATE MAILED

This communication from the Examiner in charge of your application

COMMISSIONER OF PATENTS AND TRADEMARKS

__ This application has been examined. X Responsive to communication filed on [illegible] X This action is made final.

A shortened statutory period for response to this action is set to expire 3 months, [illegible] from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. 133)

Part I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. __ Notice of References Cited by Examiner, PTO-892
2. __ Notice of Prior Art Cited by Applicant, PTO-1449
3. __ Information on How to Effect Drawing Changes, PTO-1474
4. __ Notice of Patent Drawing, PTO-948
5. __ Notice of Informal Patent Application, Form PTO-152
6. __ _____

Part II. SUMMARY OF ACTION:

1. X Claims 2 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. X Claims 1 have been cancelled.
3. __ Claims _____ are allowed.
4. X Claims 2 are rejected.
5. __ Claims _____ are objected to.
6. __ Claims _____ are subject to restriction or election requirement.

7. __ This application has been filed with informal drawings which are acceptable for examination purposes until the time at which allowable subject matter is indicated.

8. __ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. __ The corrected or substitute drawings have been received on _____. These drawings are __ acceptable; __ not acceptable (see explanation).

10. __ The __ proposed drawing correction and/or the __ proposed additional or substitute sheet(s) of drawings filed on _____ has (have) been __ approved by the examiner. __ disapproved by the examiner (see explanation).

11. __ The proposed drawing correction, filed _____, has been __ approved, __ disapproved (see explanation). Inasmuch as the Patent and Trademark Office no longer makes drawing changes, it is now application's responsibility to insure that the changes are effected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. __ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has __ been received __ not been received __ been filed in parent application, serial no. _____ filed on _____

13. __ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

14. __ Other

EXAMINER'S ACTION

1. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claim 2 is finally rejected under 35 U.S.C. 103 as being unpatentable over Ayotte or Lareau and Ossul, for the reason stated in the first Office action.

3. Applicant's arguments filed October 15, 1985 have been fully considered but they are not deemed to be persuasive.

4. Applicant argues that his 90° and 45° bend extensions are new improvements. The cited art however, proves otherwise. Extensions that have the claimed angle bends are old in the tool art. To place different combinations of extensions in a "tool kit" is also not new as all major tool catalogs show such packaging. Therefore, even the use of a set of extensions is not new.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the

shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication should be directed to James G. Smith at telephone number 703-557-6502.

12/12/85:rbb

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/[illegible]	[illegible]	[illegible]	

IRVIN D. STANGER
1019 ELLIS
WICHITA, KS 67211

EXAMINER
[illegible]

ART UNIT	PAPER NUMBER
	9

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS, AND TRADEMARKS

ADVISORY ACTION

☐ ~~THE PERIOD FOR RESPONSE IS EXTENDED TO RUN _____ MONTHS FROM THE DATE OF THE FINAL REJECTION. 37 C.F.R. 1.137~~

☐ Appellant's Brief is due in accordance with Rule 192 (a).

Applicant's response to the final rejection, filed _____, has been considered with the following effect, but it is not deemed to place the application in condition for allowance.

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

   a. ☐ There is no convincing showing under Rule 116(b).
   b. ☐ They raise new issues that would require further consideration and/or search.
   c. ☐ They raise the issue of new matter.
   d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
   e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be entered and the status of the claims in this application would be as follows:

   a. ☐ Claims _____ would be allowable.

   b. ☐ Claims _____ would not be allowable.

   However:

   (1) ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
   (2) ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☑ The affidavit, exhibit or request for reconsideration has been entered but does not overcome the rejection.

5. ☐ The affidavit or exhibit will not be admitted because applicant has not shown good and sufficient reasons why it was not earlier presented.

6. ☐ The application having been examined under the special accelerated examining procedure (M.P.E.P. 708.02), the proposed amendment has not been considered since it does not prima facie place the application in condition for allowance or in better condition for appeal.

PTO-303 (Rev. 10-90)

0255

The shortened statutory period for response expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

Any inquiry concerning this communication should be directed to James G. Smith at telephone number 703-557-6502.

James G. Smith
JAMES G. SMITH
EXAMINER
ART UNIT 323

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	

[illegible]
[illegible]
[illegible]

EXAMINER
[illegible]
ART UNIT / PAPER NUMBER
[illegible] / 5

DATE MAILED

This is a communication from the examiner in charge of your application

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☒ Notice of Informal Patent Application, Form PTO-152
5. ☒ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claim(s) 1 are pending in the application.

   Of the above, claim(s) _____ are withdrawn from consideration.

2. ☐ Claim(s) _____ have been cancelled.
3. ☐ Claim(s) _____ are allowed.
4. ☒ Claim(s) 1 are rejected.
5. ☐ Claim(s) _____ are objected to.
6. ☐ Claim(s) _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable, ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved, ☐ disapproved (see explanation). Therefore, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____, filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. ☐ Other

PTOL-326 (Rev. 7-82) EXAMINER'S ACTION

1. Receipt is acknowledged of the letter submitted by applicant dated May 26, 1986. It is noted that the letter refers to activities in an abandoned case, serial no. 671,168. A complete action on the instant application, serial no 837,504, follows.

Specification:

2. On page 1 of the specification, line 5, "in which a prior application for" should be -- which is a continuation in part of -- to clearly identify the parent application.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to provide an adequate written description of the invention.

The specification fails to disclose the ratcheting mechanism and structural cooperation between the elements of the "newly designed ratchet extension 30" to enable a ratcheting action. Correction is required with appropriate correction to the drawings. Applicant is cautioned against the inclusion of new matter.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the above objection to the specification.

Drawings:

5. The drawings are objected to since they fail to clearly disclose the structure of the "newly designed ratchet extension 30". Also, figures 23-26 must be labeled as prior art.

6. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claims:

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

It is not clear ~~is~~ if applicant is claiming a set of angled socket extensions, or a set of angled socket extensions and conventional handles and/or extensions.

8. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9. Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Snap-on Tools Corporation in view of Ossul and Ayotte.

Snap-on Tools Corporation disclose a combined set of tools including a plurality of extensions (SX-2,3,5,10 and 8-L) which includes an angular extension (8-L). Also, included in the combination of tools are various sockets, a spinner handle (NS-18-L), ratchet handles (L-715, 710), a speeder handle (K-4-L), and a sliding bar handle (S-15-L). The extensions (SX-2,3,5,10 and 8-L) include round shafts, a square drive stud at one end, and a square socket at the opposite end of the shaft. Ossul discloses an extension (f) having a 90 degree angled bend, in combination with a straight extension (a). Ayotte discloses an extension (57) having a 45 degree angled bend in combination with an extension (Figure 1). To form some of the extensions of Snap-On Tools Corp. as angled in the manner as taught by

Ossul and Ayotte would have been obvious to one having ordinary skill in the art.

10. Mandl discloses a combination set of extensions, handles, and sockets. Adolphson and Erickson disclose a combination set of extensions. Bidal disclose plural angular extensions.

11. Any inquiry concerning this communication should be directed to Examiner Meislin at telephone number 703-557-2344.

12/15/86:rbb

DSMeislin 12/14/86

DEBRA S. MEISLIN
PATENT EXAMINER
GROUP 320 - ART UNIT 323

Cancelled
10-1-76

UNITED STATES DEPARTMENT OF COMMER
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARK
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
07/104,176	10/05/87	STAGNER	

JOHN D. STAGNER
1619 ELLIS
WICHITA, KS 67211

EXAMINER
[illegible]

ART UNIT	PAPER NUMBE
[illegible]	4

DATE MAILED: 08/02/88

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

A detailed review of parent file Serial No. 06/837504 has shown that copendency did in fact exist on October 5, 1987 with this application, Serial No. 07/104176, contrary to the communication mailed July 22, 1988. Thus no action need be taken by applicant regarding application Serial No. 06/837504 to establish copendency. The Patent and Trademark Office regrets this error and any inconvenience it may have caused.

Any inquiry concerning this communication should be directed to Frederick R. Schmidt at telephone number 703-557-6506.

8/2/88

FR Schmidt:dli
8-2-88
(703) 557-6506

FREDERICK R. SCHMIDT
SUPERVISORY PATENT EXAMINER
ART UNIT 323

0000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
[illegible]	11-12-84	STINCHER	

[illegible] STINCHER
[illegible]
[illegible]

EXAMINER	
ART UNIT	PAPER NUMBER
[illegible]	3

DATE MAILED:

This is a communication from the examiner in charge of your application

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ ~~days~~ from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☑ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☑ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 1 ~~are~~ is pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1 ~~are~~ is rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable, ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____, filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. ☐ Other

0855

Serial No. 671,167

Art Unit 323

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim appears to recite only the function with no specific statement of the structure.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

3. (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

4. Claim 1 is rejected under 35 U.S.C. 102(a) as being clearly anticipated by Randall.

5. Applicant is required to submit a proposed drawing correction in response to this Office action. However, correction of the noted defect can be deferred until the application is allowed by the examiner.

6. It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period of response has lapsed, the response is considered timely. A suggested format for a certificate follows.

7. Following is a suggested format for the certificate of mailing under 37 CFR 1.8(c) which should be included with all correspondence:

"I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of

Patents and Trademarks, Washington, D.C. 20231, on.....* .

_____
Name of applicant, assignee, or registered representative

_____
Signature

_____
Date

8. Any inquiry concerning this communication should be directed to Examiner James G. Smith at telephone number 703-557-6502.

JAMES G. SMITH
EXAMINER
ART UNIT 323

9/10/85:slw.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER

ART UNIT	PAPER NUMBER
	7

DATE MAILED

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☑ Responsive to communication filed on [illegible] ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), [illegible] from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. 133)

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 2 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☑ Claims 1 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 2 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing (or amendment) filed _____ has been [illegible] the Patent and Trademark Office in lieu of the original drawing. [illegible] corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached form PTO-1474, INFORMATION ON HOW TO EFFECT DRAWING CHANGES.
12. ☐ [illegible]
13. ☐ [illegible]

0933

1. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claim 2 is finally rejected under 35 U.S.C. 103 as being unpatentable over Murray in view of Randall.

It would be obvious to modify Murry by using a hex-shaped shank, instead of square, and to secure a wrench thereto with a bolt and washer, as suggested by Randall. To use a series of different size extensions in a set is obvious to one skilled in the art.

3. Applicant's arguments filed October 15, 1985 have been fully considered but they are not deemed to be persuasive.

4. Applicant's improvement over standard wrench extensions is that the square shank is made hexagonal so that it can engage in a box-end wrench opening. Further, in order to secure the wrench to the new extension, a bolt-washer is inserted into a threaded bore in the shank end of the extension. However Randall clearly

teaches that a box wrench can be extended by using an extension with a hexagonal shank and a bolt-washer to secure it to the wrench. Thus, using the suggestion provided by Randall,a person skilled in the tool art would find it obvious to modify a standard wrench extension such as that shown at (214) in Murray.

Further, all known tool catalogs show extensions provided in various sizes in a set.

Randall clearly teaches the improvement in regard to extensions, that is the hexagonal shank and the use of a bolt-washer to secure the extension and wrench. Since what applicant claims as new is already known in the prior art, to modify Murray, in view of the teaching of Randall, is obvious.

5. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a).

Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication should be directed to James G. Smith at telephone number 703-557-6502.

0935

James G. Smith
JAMES G. SMITH

12/12/85:rbb

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D C 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
[illegible]	[illegible]	[illegible]	

[illegible]

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS, AND TRADEMARKS

ADVISORY ACTION

~~THE STATUTORY PERIOD FOR RESPONSE IS EXTENDED 3 MONTHS _____ MONTHS FROM THE DATE OF THE FINAL REJECTION 37 CFR 1.136~~

☐ Appellant's Brief is due in accordance with Rule 192 (a)

Applicant's response to the final rejection, filed _____, has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1 ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because

a ☐ There is no convincing showing under Rule 116(b)
b ☐ They raise new issues that would require further consideration and/or search
c ☐ They raise the issue of new matter
d ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal
e ☐ They present additional claims without cancelling a corresponding number of finally rejected claims

2 ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims

3 ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be, entered and the status of the claims in this application would be as follows:

a ☐ Claims _____ would be allowable

b ☐ Claims _____ would not be allowable

However:

(1) ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.

(2) ☐ The rejection of claims _____ on non reference grounds only is deemed to be overcome by applicant's response

4 ☒ The affidavit, exhibit or request for reconsideration has been entered but does not overcome the rejection

5 ☐ The affidavit or exhibit will not be admitted because applicant has not shown good and sufficient reasons why it was not earlier presented.

6 ☐ The application having been examined under the special accelerated examining procedure (M.P.E.P. 708.02), the proposed amendment has not been considered since it does not prima facie place the application in condition for allowance or in better condition for appeal

The shortened statutory period for response expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

Any inquiry concerning this communication should be directed to James G. Smith at telephone number 703-557-6302.

James G. Smith
JAMES G. SMITH
EXAMINER
ART UNIT 323

Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
[illegible]	[illegible]	[illegible]	

EXAMINER	
[illegible]	
ART UNIT	PAPER NUMBER
	5

DATE MAILED

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

[X] This application has been examined [ ] Responsive to communication filed on _____ [ ] This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. [X] Notice of References Cited by Examiner, PTO-892.
2. [X] Notice re Patent Drawing, PTO-948.
3. [ ] Notice of Art Cited by Applicant, PTO-1449
4. [X] Notice of Informal Patent Application, Form PTO-152
5. [X] Information on How to Effect Drawing Changes, PTO-1474
6. [ ] _____

Part II SUMMARY OF ACTION

1. [X] Claims 1 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.
2. [ ] Claims _____ have been cancelled.
3. [ ] Claims _____ are allowed.
4. [X] Claims 1 are rejected.
5. [ ] Claims _____ are objected to.
6. [ ] Claims _____ are subject to restriction or election requirement.
7. [X] This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. [ ] Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. [ ] The corrected or substitute drawings have been received on _____. These drawings are [ ] acceptable, [ ] not acceptable (see explanation).
10. [ ] The [ ] proposed drawing correction and/or the [ ] proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been [ ] approved by the examiner. [ ] disapproved by the examiner (see explanation).
11. [ ] The proposed drawing correction, filed _____, has been [ ] approved, [ ] disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. [ ] Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has [ ] been received [ ] not been received [ ] been filed in parent application, serial no. _____, filed on _____
13. [ ] Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. [ ] Other

PTOL-326 (Rev. 7-82) EXAMINER'S ACTION

1. Receipt is acknowledged of the letter submitted by applicant dated May 26, 1986. It is noted that the letter refers to activities in an abandoned case, Serial No. 671,167. A complete action on the instant application, Serial No. 837,430, follows.

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

3. Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claims must be in one sentence form only. Note the format of the claims in the patents cited.

It is not known from the claim what the "improved tool" consists of in the claim, only that it includes elements that are not structurally related.

4. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> [illegible] shall not be [illegible] as prior art only under subsection (g)

and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Randall, Jr. in view of Murray and Osburn.

Randall, Jr. discloses all of the claimed subject matter except for having a "set" of wrench extensions of differing sizes and a "square socket head" on one end of the extension. Murray discloses a wrench extension for engagement with a double ended wrench at one end and a square socket head (64) at the opposite end thereof. It would have been obvious to one having ordinary skill in the art to form one end of the extension of Randall, Jr. with a square socket head such that any standard socket tool may be receivnd therein to provide a variety of specially adapted obstruction by-pass tools as taught by Murray. Osburn discloses a plurality or set of wrench extensions (4, 5) having differently sized hexagonal socket engaging portions (B', D'). It would have been obvious to one having ordinary skill in the art to form the device of Randall, Jr. as a set of wrench extensions to form a variety of tools of different sizes, lengths, and shape for workpieces having difficult access as taught by Osburn. The amount of extensions and the sizes of each would have been an obvious matter of choice.

6. Any inquiry concerning this communication should be directed to Examiner Meislin at telephone number 703-557-2344.

D. Meislin:klw

2-26-87

(703) 557-2344

D Meislin 3/2/87

DEBRA MEISLIN
PATENT EXAMINER
GROUP 320 - ART UNIT 323

NOTICE OF REFERENCES CITED	837430	323		5
	APPLICANT(S): Stagner			

U.S. PATENT DOCUMENTS

*		DOCUMENT NO	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	A	1446988	2-1923	Osborn	81	124.4	
	B	2743642	5-1956	Randall Jr	81	124.4	
	C	3996821	12-1976	Murray	81	58 x	
	D	3376768	4-1968	Fortunato	81	177.2	
	E						
	F						
	G						
	H						
	I						
	J						
	K						

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO	DATE	COUNTRY	NAME	CLASS	SUB CLASS	PERTINENT SECTIONS OF SPEC.
	L							
	M							
	N							
	O							
	P							
	Q							

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

R	
S	
T	
U	

EXAMINER	DATE
D. Maislin	2/25/87

* A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, section 707.05(a).)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
[illegible]

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	

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EXAMINER	
[illegible]	
ART UNIT	PAPER NUMBER
[illegible]	8

DATE MAILED
[illegible] 9 [illegible]

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 3-26-87 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. ☒ Claims 2 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 2 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter has been indicated. Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The proposed drawing correction and/or the proposed additional or substitute sheet of drawings, filed on _____ has/have been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☒ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). Therefore, the drawings of this application are accepted by the Patent and Trademark Office as complying with the requirements of 37 CFR 1.84 except that marginal requirements are not met and formal changes must be made. Failure to take the required action set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474 will result in abandonment of the application.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received in parent application serial no. _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. ☐ Other:

1342

1. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claim 2 is rejected under 35 U.S.C. 103 as being unpatentable over Randall Jr. in view of Murray and Osburn, all of record.

Randall, Jr. discloses all of the claimed subject matter except for having a "set" of extensions and a square socket head on one end of the extension. Note the straight, round shaft (12), flange (20), hexagonal nut shaped base (22), a washer (26) and a bolt (24, 28) which constitutes an extension handle for box wrenches. The opposite end of the extension has a threaded socket therein. Murray discloses a wrench extension for standard open-end or box-end wrenches including one end for connection to the wrench and its opposite end having formed as a standard square socket head. Note the socket (64) for engagement with a drive stud. It would have been obvious to one having ordinary

skill in the art to form one end of the extension of Randall, Jr. as a square socket head such that any standard tool may be received therein to provide a variety of specially adapted costruction by-pass tools as taught by Murray. Osburn discloses a plurality or set of wrench extensions (4, 5) having differently sized hexagonal socket engaging portions (B', D'). It would have been obvious to one having ordinary skill in the art to form the device of Randall, Jr. as a set of wrench extensions of various sizes, to enable utilization of the device on various sized workpieces having difficult access as taught by Osburn providing versalitity. The amount of extensions and their exact sizes would have been an obvious matter of choice as such sizes are notoriously old and well known in the art of wrenches. Note that to forge the device of Randall, Jr. and to form the flange, nut, and shaft as a unitary structure would have been obvious to one having ordinary skill in the art as such is merely an obvious engineering choice dependent upon choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the device. Forging is an old and well known process and would have been an obvious method of manufacture.

3. Claim 1 has been canceled.

Remarks:

4. Applicant's arguments filed March 26, 1987 have been fully considered but they are not deemed to be persuasive.

The claim was properly rejected under 35 USC 103 as being unpatentable over Randall, Jr. in view of Murray and Osburn. The determination of obviousness follows the test for obviousness using Graham V. Deere.

The factual inquiries set forth in Graham v. John Deere Co. that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue; and
3. Resolving the level of ordinary skill in the pertinent art.

Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (.966).

5. Applicant's arguments with respect to any petition(s) are not on point.

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a).

Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication should be directed to Examiner Meislin at telephone number 703-557-2344.

6/9/87 srh
6/12/87
6/15/87

6/17/87
FREDERICK R. SCHMIDT
SUPERVISORY PATENT EXAMINER
ART UNIT 323

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/837,430	03/10/86	STAGNER	1

IRVIN D. STAGNER
1819 ELLIS
WICHITA, KS 67211

EXAMINER	
ART UNIT	PAPER NUMBER
	11

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE

☐ is extended to run _____ from the date of the Final Rejection

☐ continues to run _____ from the date of the Final Rejection

☒ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 7/7/87, has been considered with the following affect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
   - a ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
   - b ☐ They raise new issues that would require further consideration and/or search. (See Note).
   - c ☐ They raise the issue of new matter. (See Note).
   - d ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
   - e ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

   NOTE _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be, entered and the status of the claims in this application would be as follows:

   Allowed claims: _____

   Claims objected to: _____

   Claims rejected: _____

   However:

   - a ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
   - b ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☒ The ~~affidavit, exhibit~~ or request for reconsideration has been considered but does not overcome the rejection.

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

1369

9/15/87

FREDERICK R. SCHMIDT
SUPERVISORY PATENT EXAMINER

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS, Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	✓

DATE MAILED

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined. ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 months, _____ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims _____ are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable. ☐ not acceptable (see explanation).
10. ☐ The proposed drawing correction and/or the proposed additional or substitute sheet(s) of drawings, filed on _____ has/have been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). Therefore, the drawings in this application are now considered by the Patent and Trademark Office to be informal. Applicant must submit new drawings in response to this Office action. The drawings must be corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has been ☐ received. ☐ not received. ☐ been filed in parent application, serial no. _____, filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. ☐ Other.

PTOL-326 (Rev. 1-82) EXAMINER'S ACTION

1650

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant appears to claim the standard wrench ratchet twice.

2. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Lechaug in view of the "G.M." disclosure p.86. It would be obvious to modify Lechaug by using a square hole, as opposed to a permanent handle, as such is suggested to be well known by the "G.M." disclosure.

4. It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the

response is being mailed on a given date. So mailed, before the period of response has lapsed, the response is considered timely. A suggested format for a certificate follows.

5. Following is a suggested format for the certificate of mailing under 37 CFR 1.8(c) which should be included with all correspondence:

"I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on....." .

Name of applicant, assignee, or registered representative

Signature

Date

6. Any inquiry concerning this communication should be directed to Examiner James G. Smith at telephone number 703-557-6502.

9/10/85:slw.

FORM PTO-892 (REV. 3-78)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED

SERIAL NO	GROUP ART UNIT	ATTACHMENT TO PAPER NUMBER	
671169	323		4

APPLICANT(S): Stacy et al

U.S. PATENT DOCUMENTS

*		DOCUMENT NO	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
✓	A	2,260,761	9/1941	Lee et al	87	177.2	
✓	B	731,888	6/1903	George	87	177.2	
✓	C	3,467,908	9/1969	Rand	87	016.5	
✓	D	2,832,246	4/1958	Livermont	87	016.5	
✓	E	3,343,434	9/1967	Schneeberg	87	60	
	F						
	G						
	H						
	I						
	J						
	K						

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO	DATE	COUNTRY	NAME	CLASS	SUB CLASS	PERTINENT SHEETS DRAWING	PP. DESC.
	L								
	M								
	N								
	O								
	P								
	Q								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

✓	R	"Service Tools for GM Cars", Sunnen Tool Catalog, 5/1951, pp 86 & 87
	S	
	T	
	U	

EXAMINER	DATE
James C. Smith	9/6/85

* A copy of this reference is not being furnished with this office action.
See Manual of Patent Examining Procedure, section 707.05(a).

1653

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	5

DATE MAILED

This is a communication from the examiner in charge of your application

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☑ Responsive to communication filed on 10-15-85 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ ____

Part II SUMMARY OF ACTION

1. ☑ Claims 2 are pending in the application.

   Of the above, claims ____ are withdrawn from consideration.

2. ☑ Claims 1 have been cancelled.
3. ☐ Claims ____ are allowed.
4. ☑ Claims 2 are rejected.
5. ☐ Claims ____ are objected to.
6. ☐ Claims ____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on ____. These drawings are ☐ acceptable. ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on ____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed ____, has been ☐ approved. ☐ disapproved (see explanation). Therefore, the Patent and Trademark Office no longer makes drawing changes. It is now incumbent upon applicant's attorney or agent to place the drawing in condition for allowance. corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ____, filed on ____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. ☐ Other

PTOL-326 (Rev. 7-82) EXAMINER'S ACTION

1716

1. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claim 2 is finally rejected under 35 U.S.C. 103 as being unpatentable over Leehaug in view of the G. M." disclosure page 86, for the reason stated in the first Office action.

3. Applicant's arguments filed October 15, 1985 have been fully considered but they are not deemed to be persuasive.

4. Applicant's numerous court decisions regarding unobviousness are noted, however Leehaug clearly shows a U-shaped member with a handle on one side and a ratchet on the other. Further, the G.M. disclosure provides a clear suggestion to one skilled in the art that a square hole can be attached to a U-shaped member to allow a removable turning handle to be secured. To therefore modify Leehaug, in view of this clear teaching, is obvious.

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication should be directed to Examiner James G. Smith at telephone number 703-557-6502.

James G. Smith
JAMES G. SMITH
EXAMINER
ART UNIT 323

12/11/85:cjk

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	

[illegible]
[illegible]
[illegible]

EXAMINER
ART UNIT / PAPER NUMBER
10

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS, AND TRADEMARKS

ADVISORY ACTION

☐ [illegible] REFERENCE [illegible] RULE [illegible] THE [illegible] FINAL REJECTION [illegible]

☐ Appellant's Brief is due in accordance with Rule 192 (a)

Applicant's response to the final rejection, filed _____, has been considered with the following effect, but it is not deemed to place the application in condition for allowance

1 ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because

a ☐ There is no convincing showing under Rule 116(b)
b ☐ They raise new issues that would require further consideration and/or search
c ☐ They raise the issue of new matter
d ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal
e ☐ They present additional claims without cancelling a corresponding number of finally rejected claims

2 ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non allowable claims

3 ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be entered and the status of the claims in the application would be as follows

a ☐ Claims _____ would be allowable

b ☐ Claims _____ would not be allowable

However

(1) ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response

(2) ☐ The rejection of claims _____ on non reference grounds only is deemed to be overcome by applicant's response

4 ☑ The affidavit, exhibit or request for reconsideration has been entered but does not overcome the rejection

5 ☐ The affidavit or exhibit will not be admitted because applicant has not shown good and sufficient reasons why it was not earlier presented

6 ☐ The application having been examined under the special accelerated examining procedure (M.P.E.P. 708.02), the proposed amendment has not been considered since it does not prima facie place the application in condition for allowance or in better condition for appeal

Official Rec. [illegible]

1812

The shortened statutory period for response expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

Any inquiry concerning this communication should be directed to James G. Smith at telephone number 703-557-6502.

James G. Smith
JAMES G. SMITH
EXAMINER
ART UNIT 323

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
06/837,502	03/10/86	STAGNER T	

IRVIN D. STAGNER
1014 ELLIS
WICHITA, KS 67211

EXAMINER
[illegible]

ART UNIT	PAPER NUMBER
333	5

DATE MAILED: 07/15/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

[X] This application has been examined. [ ] Responsive to communication filed on _____. [ ] This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. [X] Notice of References Cited by Examiner, PTO-892.
2. [X] Notice re Patent Drawing, PTO-948.
3. [ ] Notice of Art Cited by Applicant, PTO-1449.
4. [ ] Notice of Informal Patent Application, Form PTO-152.
5. [X] Information on How to Effect Drawing Changes, PTO-1474.
6. [ ] _____

Part II SUMMARY OF ACTION

1. [X] Claims 1 - 3 pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. [ ] Claims _____ have been cancelled.
3. [ ] Claims _____ are allowed.
4. [X] Claims 1 - 3 are rejected.
5. [ ] Claims _____ are objected to.
6. [ ] Claims _____ are subject to restriction or election requirement.
7. [X] This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. [ ] Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. [ ] The corrected or substitute drawings have been received on _____. These drawings are [ ] acceptable; [ ] not acceptable (see explanation).
10. [ ] The [ ] proposed drawing correction and/or the [ ] proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been [ ] approved by the examiner. [ ] disapproved by the examiner (see explanation).
11. [ ] The proposed drawing correction, filed _____, has been [ ] approved. [ ] disapproved (see explanation). Therefore, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. [ ] Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has [ ] been received. [ ] not been received. [ ] been filed in parent application, serial no. _____, filed on _____.
13. [ ] Since this application appears to be in condition for allowance except for formal matters, prosecution is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. [ ] Other.

1978

1. Receipt is acknowledged of the letter submitted by applicant dated May 26, 1986. It is noted that the letter refers to activities in an abandoned case, Serial No. 671,169. A complete action on the instant application, Serial No. 837,502, follows.

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

3. Applicant is reminded of the proper content of an Abstract of the Disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an imorovement in an old apparatus, process, product, or comoosition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not oovious, the abstract should set forth a process for making and/or use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

4. Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patents cited.

It is not known from the claim what the "improved tool" comprises as the claims recite numerous elements that are not structurally related.

6. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention

1950

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claim 1, is best understood, is rejected under 35 U.S.C. 103 as being unpatentable over Snap-On-Tools in view of Schroeder.

Snap-On-Tools discloses U-shaped handles having a wrench at one end and a drive stud receiving socket in the opposite end as seen on page 84 ([B] S-8666) and page 86 ([A]-[E] S-8164-A, S-9524, S-8663, S-9825, S-9825B, S-9513-C). Schroeder discloses a U-shaped handle having a ratchet wrench (14-17) at one end thereof. It would have been obvious to one having ordinary skill in the art to form the wrench end of the Snap-On-Tools as a ratchet wrench to enable ratcheting of the wrench as taught by Schroeder. Note that the type of ratchet wrench claimed is admitted as "standard" by applicant.

8. Johnson and Leehaug are cited to show ratchet wrench, having a U-shaped handle.

9. Any inquiry concerning this communication should be directed to Examiner Meislin at telephone number 703-557-2344.

2/13/87 srh

Debra Meislin 2/17/87
DEBRA MEISLIN
PATENT EXAMINER
GROUP 320 - ART UNIT 323

FORM PTO-892 (REV. 3-78) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED

SERIAL NO	GROUP ART UNIT	ATTACHMENT TO PAPER NUMBER	
837502	323		5

APPLICANT(S) Stagner

U.S. PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE
	A	D261591	9-1981	Leeburg	81	177.2 x	
	B	754069	3-1904	Johnson	81	177.85 x	
	C	3304343	9-1967	Schroeder	81	177.2 x	
	D						
	E						
	F						
	G						
	H						
	I						
	J						
	K						

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO	DATE	COUNTRY	NAME	CLASS	SUB-CLASS	PERTINENT SECTIONS OF DRAWINGS
	L							
	M							
	N							
	O							
	P							
	Q							

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

R	"Service Tools For GM Cars" and "Special Tool Service Tools That Save", Snap-On Tool Catalog S-451 pp 54, 56, 87, & 177.1
S	
T	
U	

EXAMINER D. Weston DATE 3/12/87

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO
06/837,502	03/10/86	STAGNER	

IRVIN D. STAGNER
1014 ELLIS
WICHITA, KS 67211

EXAMINER	
[illegible]	
ART UNIT	PAPER NUMBER
[illegible]	8

DATE MAILED: 06/11/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 3-19-87 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 2 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 2 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable, ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved, ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____, filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
14. ☐ Other

1. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claim 2 is rejected under 35 U.S.C. 103 as being unpatentable over Snap-On-Tools in view of Schroeder, both of record.

Snap-On-Tools discloses U-shaped handles having a wrench at one end and a drive stud receiving socket in the opposite end as seen on page 84 ([B] S-~~86636~~ 8666) and page 86 ([A]-[E] S-8164-A, S-9524, S-8663, S-9825, S-9825B, S-9513-C) Schroeder discloses a U-shape handle having a conventional ratchet mechanism (14-17) at one end thereof. It would have been obvious to one having ordinary skill in the art to form the wrench portion of Snap-On-Tools as a ratchet wrench to enable ratcheting of the wrench as taught by Schroeder such that a workpiece may be rotated with constant engagement by the wrench. The type of ratchet wrench claimed is admitted prior art.

3. Claim 1 has been canceled.

REMARKS:

4. Applicant's arguments filed March 19, 1987 have been fully considered but they are not deemed to be persuasive.

The claim was properly rejected under 35 USC 103 as being unpatentable over Snap-On-Tools in view of Schroeder. The determination of obviousness follows the test for obviousness using Graham v. Deere.

The factual inquiries set forth in Graham v. John Deere Co. that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are summarized as follows:

> 1. Determining the scope and contents of the prior art;
> 2. Ascertaining the differences between the prior art and the claims at issue; and
> 3. Resolving the level of ordinary skill in the pertinent art.

Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

5. Applicant's arguments with respect to any petitions are not on point.

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a).

Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM

THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication should be directed to Examiner Meislin at telephone number 703-557-2344.

6/9/87

FREDERICK R. SCHMIDT
SUPERVISORY PATENT EXAMINER
ART UNIT 323

6/9/87

D. Meislin:klw

6-5-87

(703) 557-2344

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/837,502	03/10/86	STAGNER, I.	

IRVIN D. STAGNER
1819 ELLIS
WICHITA, KS 67211

EXAMINER
[illegible]
ART UNIT	**PAPER NUMBER**
323	11

DATE MAILED: 09/13/87

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE

☐ is extended to run _____ from the date of the Final Rejection

☐ continues to run _____ from the date of the Final Rejection

☒ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 7/7/87, has been considered with the following effect, but it is not deemed to place the application in condition for allowance.

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
   - a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
   - b. ☐ They raise new issues that would require further consideration and/or search. (See Note)
   - c. ☐ They raise the issue of new matter. (See Note)
   - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
   - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

   NOTE _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment canceling the non-allowable claims.

3. ☐ Upon the filing of an appeal, the proposed amendment ☐ will be ☐ will not be entered, and the status of the claims in this application would be as follows:

   Allowed claims _____
   Claims objected to: _____
   Claims rejected _____

   However:
   - a. ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
   - b. ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☒ The ~~[illegible]~~ or request for reconsideration has been considered but does not overcome the rejection.

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

9/10/87

EXAMINER

Group 320
Art Unit 323
aw

UNITED STATES D. ·ARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

February 13, 1986

#10

In re application of:
Irvin D. Stagner :
Serial Number: 671,168 : DECISION ON PETITION
Filed: November 13, 1984 : JANUARY 2, 1986
For: COMBINED 90 DEGREE AND 45 :
DEGREE ANGLED SOCKET :
EXTENSION SET

This is in response to the petition filed January 2, 1986 under 37 C.F.R. 1.181 requesting the Commissioner to invoke his supervisory authority and cause reexamination and reconsideration of this application.

The petitioner argues first that the Examiner's rejections were incomplete and not in compliance with 37 C.F.R. 1.104(a) and 37 C.F.R. 1.105 and second that the Examiner had erred in rejecting the claims on the prior art references.

With regard to petitioner's first argument, it is pointed out that the petition does not show specifically how 37 C.F.R. 1.104(a) and 1.105 have not been complied with. These Rules require the Examiner to give the application complete examination as to merit and form. A review of the record indicates that the Examiner has done so and thus it is not agreed that he has failed to comply with these Rules.

The remaining and second argument appears to be directed entirely to the merits of the Examiner's rejection of the claim.

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him the patent protection to which he is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art, as is the situation here, the questions thereby raised are said to relate to merits. The statutes provide an Appeal procedure to the combined Board of Appeals and Interferences to resolve these differences.

The petition is DENIED.

Samih Zaharna

Samih N. Zaharna, Director
Patent Examining Group 320
Mateial Shaping,
Article Manufacturing, Tools

Irvin D. Stagner 0257
1814 Ellis
Wichita, Kansas 67211

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t Unit 323

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ril 29, 1987

re application of:
vin D. Stagner :
rial Number: 837,430 :
led: March 10, 1986 :
: WRENCH EXTENSION SET : ON PETITION

is is in response to the petition filed under 37 C.F.R. 1.181 on rch 26, 1987 requesting the next action by the Examiner be orough and in compliance with the patent statutes and rules.

itioner argues the March 3, 1987 Office action was incomplete cause: (1) the Examiner did not cite the best references;) the Examiner did not explain the rejection clearly; and) the Examiner substituted herself for a person of ordinary ill in the art.

itioner's basis for alleging the Examiner did not cite the best ferences is not understood. How did the petitioner conclude that re is better prior art. Is petitioner aware of other prior material to the examination of the application and better than t cited by the Examiner? If so, petitioner is reminded of his y under 37 C.F.R. 1.56 to disclose material prior art and the sibility of rejection under 35 U.S.C. 131 and 132 for failure discharge that duty.

h regard to the second point, it is not clear what portions of rejection the petitioner believes have not having been fully lained. Petitioner has not cited any specific deficiencies in March 3, 1987 Office action as set forth by 37 C. F.R. 1.111.

h regard to the third point, the patent statutes, rules and ent and Trademark Office procedure require the Examiner to olve the level of ordinary skill in the art in every ermination of obviousness. This is what the Examiner has done this case and hence it is not seen where the Examiner has done thing other than what is required by the statutes, the rules Patent and Trademark the practice and procedure.

petition is GRANTED to the extent that all Office actions will tinue to be clear and complete.

ih N. Zaharna, Director
ent Examining Group 320
erial Shaping,
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in D. Stagner
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hita Kansas 67211

Group 320
Art Unit 323
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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

May 15, 1986

#13

In re application of:
Irvin D. Stagner :
Serial Number: 671,167 : RESPONSE TO COMMUNICATION
Filed: November 13, 1984 : FILED MARCH 3, 1986 and
For: WRENCH EXTENSION SET : MARCH 10, 1986

This is in response to the communication received March 3 and two communications received March 10, 1986.

The communication of March 3, 1986 is being treated as a request for reconsideration of the Decision on Petition mailed February 13, 1986. Petitioner argues the main points of the petition were overlooked and not studied thoroughly. However, petitioner has failed to specify exactly which points were overlooked. Both the petition and request for reconsideration have been carefully studied. No factual evidence has been submitted that would alter the February 13, 1986 Decision. Thus the request for reconsideration has been granted, however the decision on petition mailed February 13, 1986 stands.

One communication filed March 10, 1986 consists of a listing of legal interpretations of the patent statutes and general allegations regarding the patentability of the wrench extension set. This paper has been made of record in the application file but is not responsive to the December 18, 1985 final rejection.

The other communication filed March 10, 1986 consists of a copy of the petition filed January 2, 1986 and a copy of the application papers as originally filed along with a request to file a new application. The request for filing a new application is incomplete because it does not include the $170.00 small entity filing fee required by 37 C.F.R. 1.16. The maximum six month period for response to the final rejection ends June 18, 1986. Any further action by petitioner (i.e. filing of a notice of Appeal or filing of a new application with continuity to this parent application) must be filed in the U. S. Patent and Trademark Office by that date.

Summary: The request for reconsideration is GRANTED, however it does not effect the Decision on Petition of February 13, 1986.

Samih Zaharna

Samih N. Zaharna, Director
Patent Examining Group 320
Material Shaping,
Article Manufacturing, Tools

Irvin D. Stagner
1814 Ellis
Wichita, Kansas 67211

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#10

AMT/BRG/myl

AUG 21 1987

Mr. Irvin D. Stagner
1814 Ellis
Wichita, Kansas 67211

Dear Mr. Stagner:

Thank you for your letters received February 19, 1987, March 20, 1987 and March 26, 1987 concerning applications Serial Nos. 837,430, and 837,502 and 837,504 and the corresponding parent applications Serial Nos. 671,167, and 671,168 and 671,169.

In response to your inquiry concerning the actions and communications you have had with patent examining professionals of Examining Group 320 relating to the above identified applications, a careful review has been made of all records concerning the prosecution of these applications. There is nothing of record which would indicate that either Mr. Zaharna, the Group Director, or his examiners have acted in any manner inconsistent with the statutes and rules governing the prosecution of applications for patents. In fact, the record would seem to indicate that Mr. Zaharna and his examiners have provided more than ample assistance to you as an applicant from both the legal and procedural aspects of applying for a patent.

Part of your difficulty may arise from the complex nature of the proceedings which often occur in prosecuting patent applications. For example, you made numerous complaints about receiving "ex parte examination". Since all proceedings before the Patent and Trademark Office are to be ex parte proceedings, except for interference proceedings which are not applicable here, it would be improper for your applications or any application to be considered in any other manner. Ex parte examination means that the Patent and Trademark Office will deal only with applicant or his appointed representative. Third parties may not be involved in the Office's consideration of a patent application.

It also appears that you may not fully appreciate the distinction between appealable and petitionable matters. As stated in the Manual of Patent Examining Procedure (page 1, column 2, paragraph 3), "the portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see §1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Appeals (see §1201)." Rejections of claims based upon prior art (i.e., 35 U.S.C. 102 and/or 35 U.S.C. 103) clearly relate to the merits of the case and, therefore, are appealable rather than petitionable matters.

In view of the above, Mr. Zaharna rendered a proper decision on your petition filed under 37 CFR 1.181, since the rejection of claims was based on prior art which is in fact on the merits. As already indicated, issues concerning rejections on the merits are resolvable only by appeal.

Since the prosecution of patent applications involves complex legal and technical issues, it cannot be emphasized enough that, whenever possible, applicants should obtain the assistance and expertise of a patent practitioner. In any case in view of the history and present status of your applications, it is believed that procurement of the services of a patent practitioner would expedite further processing, maximize protection of your rights to any patentable invention(s), and alleviate your concerns about fair and equal treatment.

Sincerely yours,

James E. Denny
Deputy Assistant Commissioner for Patents

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SEP 17 1987

#10½

Mr. Irvin Stagner 1814
1814 Ellis
Wichita, Kansas 67211

Dear Mr. Stagner:

This is in response to your letters addressed to Mr. James E. Denny and Mr. Donald Quigg, respectively, received September 1, 1987 concerning applications Serial Numbers 837,430; 837,502; and 837,504.

The letters allege that the patent examining professionals of Examining Group 320 are one-sided in the examination of your applications and are not willing to accept the evidence of patentability that you have presented. A request is made under 37 CFR 1.181(a) to bring corrective action and cause the examiner to be equal toward your applications as the examiner is toward the prior art.

A review of the prosecution history of the involved applications finds nothing of record to indicate that either Mr. Zaharna, the Group Director, or his examiners acted in any manner inconsistent with the statutes and rules governing the prosecution of applications for patents. Also, there is nothing of record to support the allegation that the examiner has not considered your arguments for patentability.

As stated in the Manual of Patent Examining Procedure at page 1, column 2, paragraph 3, "That portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see §1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits may be reviewed by appeal to the Board of Appeals (see §1201)." The rejection of the claims based upon prior art is accordingly an appealable matter rather than petitionable. Applicant's disagreement with the examiner over the relevance of the prior art must be appealed to the Board of Patent Appeals and Interferences.

A review by the Commissioner under 37 CFR 1.181(a) is inappropriate in this instance as your applications are subject to appeal and no inappropriate action on the part of the examining personnel in Group 320 has been shown.

Sincerely yours,

Jeffrey V. Nase
Petitions Examiner
Office of the Deputy Assistant
Commissioner for Patents

1201 Introduction

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Appeals and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within two months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. Note In re Hengehold, 169 USPQ 473 (CCPA 1971).

1202 Channels of Ex Parte Review